FILED

00 689 OCT 27 2000

OFFICE OF THE CLERK

No. 00-

IN THE

Supreme Court of the United States

MICHAEL BOLTON, individually and d/b/a MR. BOLTON'S MUSIC, INC., ANDREW GOLDMARK, NONPAREIL MUSIC, INC., WARNER CHAPPELL MUSIC LIMITED, WARNER TAMERLANE PUBLISHING CORP., WB MUSIC CORP., and SONY MUSIC ENTERTAINMENT, INC.,

Petitioners,

v.

THREE BOYS MUSIC CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

ROBERT G. SUGARMAN
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
(212) 310-8184

ALAN M. DERSHOWITZ
Counsel of Record
1525 Massachusetts Avenue
Cambridge, MA 02138
(617) 495-4617

RUSSELL J. FRACKMAN
MITCHELL SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064
(310) 312-2000

Attorneys for Petitioners

163147

Counsel Press LLC
(800) 274-3321 • (800) 359-6859

99pp

QUESTIONS PRESENTED

1. Should this Court grant review of the Ninth Circuit's decision and opinion in this case — the largest reported music infringement judgment involving a single song, which creates a striking and important conflict with the governing law in other Circuits regarding the proper division of authority between judge and jury in the recurring infringement cases involving "weak" claims of access (as the Ninth Circuit acknowledged is the case here)?

2. Should this Court grant review of the Ninth Circuit's decision, which conflicts with the decision of this Court in *Feist Publications, Inc. v. Rural Telegraph Service Co.*, 499 U.S. 340 (1991), by allowing a jury infringement verdict predicated on substantial similarity of protectible expression to stand based on the mere combination "of five unprotectible elements," thereby undercutting the important copyright and First Amendment protections that "encourage[ ] authors to build freely on the ideas and information" of predecessors? *Id.* at 349-350.

3. Should this Court grant review of the Ninth Circuit's refusal to apply the logical and necessary corollary of its "inverse-ratio rule," thus perpetuating confusion over the proper test to be applied — by judge and jury — in cases where both the evidence of access is weak and the evidence of substantial similarity is questionable (as it was here)?

STATEMENT PURSUANT TO RULE 29.6

Petitioners Mr. Bolton's Music, Inc. and Nonpareil Music, Inc. certify that they do not have any parent corporations and that no publicly held company owns 10% or more of Petitioners' stock.

Petitioner Warner Chappell Music Ltd. certifies that Warner Chappell Music (UK) Ltd. is the parent of Petitioner and/or owns 10% or more of Petitioner's stock.

Petitioners Warner Tamerlane Publishing Corp., and WB Music Corp. certify that Warner Communications, Inc. is the parent of Petitioners and/or owns 10% or more of Petitioners' stock.

Petitioner Sony Music Entertainment, Inc. certifies that Sony Music Holding Inc. is the parent of Petitioner and/or owns 10% or more of Petitioner's stock.

No publicly held company, other than as listed above, owns 10% or more of the stock of any corporate petitioner.

TABLE OF CONTENTS

	Page
Questions Presented	i
Statement Pursuant to Rule 29.6	ii
Table of Contents	iii
Table of Cited Authorities	v
Table of Appendices	viii
Opinions Below	1
Statement of Jurisdiction	1
Statutory Provisions Involved	1
Preliminary Statement	1
Statement of the Case	3
Reasons for Granting the Writ	6
I. The Ninth Circuit's Decision Creates a Conflict in the Circuits and with the Decisions of this Court Regarding the Proper Standard for Reviewing a Weak Claim of Access	6
A. There is a Conflict in the Circuits	6
B. There is a Conflict with Decisions of this Court	9

Contents

Page

II. The Ninth Circuit Opinion on Substantial Similarity of Protectible Expression Conflicts with a Prior Decision of this Court 11

III. The Ninth Circuit's Refusal Evenhandedly to Apply the "Inverse-Ratio Rule" Skews the Law so as to Favor Weak Infringement Cases and thereby Undermines the Constitutional Rationale of the Copyright Law 12

Conclusion 13

TABLE OF CITED AUTHORITIES

Page

Cases:

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986) 2, 9

ARC Music Corp. v. Lee, F.2d 186 (2d Cir. 1961) 12

Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946) .. 2, 7, 8, 9

Beal v. Lindsay, 468 F.2d 287 (2d Cir. 1972) 8

Beal v. Paramount Pictures, 20 F.3d 454 (11th Cir. 1994) 12

Benson v. Coca-Cola Co., 795 F.2d 973 (11th Cir. 1986) 8

Celotex Corp. v. Catrett, 477 U.S. 317 (1986) 2

Derrick Coles, et al. v. Stevie Wonder, et al., United States District Court, Northern District of Ohio, Eastern Division, Case No. 1:98 CV 433 9

Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) ..... i, 2, 3, 10, 11, 13

Ferguson v. National Broadcasting Co., Inc., 584 F.2d 111 (5th Cir. 1978) 8

Cited Authorities

	Page
Fogerty v. Fantasy, Inc., 510 U.S. 517 (1994)	2, 13
Gaste v. Kaiserman, 863 F.2d 1061 (2d Cir. 1988) ..	8
Heyman v. Commerce & Industry Ins. Co., 524 F.2d 1317 (2d Cir. 1975)	8
Maxtone-Graham v. Burtchaell, 803 F.2d 1253 (2d Cir. 1986)	8
Moore v. Columbia Pictures Industries, Inc., 972 F.2d 939 (8th Cir. 1992)	8
Selle v. Gibb, 741 F.2d 896 (7th Cir. 1984)	8
Sid & Marty Krofft Television Productions v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977)	7, 11
Takeall v. Pepsico, 809 F. Supp. 19 (D. Md. 1992), *aff'd*, 14 F.3d 596 (4th Cir. 1993)	8
Three Boys Music Corporation v. Bolton, et al., 212 F.3d 477 (9th Cir. 2000)	2, 9
Twentieth Century Music Corp. v. Aiken, 422 U.S. 151 (1975)	10
Warner Bros. v. ABC, Inc., 720 F.2d 231 (2d Cir. 1983)	7, 9

Cited Authorities

Page

Unitd States Constitution:

First Amendment ..... i, 3, 10

Statute:

28 U.S.C. § 1254(1) 1

TABLE OF APPENDICES

Page

Appendix A — Opinion Of The United States Court Of Appeals For The Ninth Circuit Dated And Filed May 9, 2000 ..... 1a

Appendix B — Final Judgment Of The United States District Court For The Central District Of California Dated And Filed December 18, 1996 ..... 24a

Appendix C — Order Of The United States District Court For The Central District Of California Re Defendants' Motions For Judgment As A Matter Of Law And For A New Trial Dated August 10, 1994 And Filed August 11, 1994 ..... 26a

Appendix D — Order And Judgment Of The United States District Court For The Central District Of California Re Phase II Dated And Filed April 29, 1994, And Dated And Filed May 6, 1994, Respectively 61a

Appendix E — Civil Minutes Of The United States District Court For The Central District Of California Re Denial Of Defendants' Motions For Judgment As A Matter Of Law And A New Trial Dated March 1, 1993 ..... 65a

Appendices

Page

Appendix F — Order Of The United States Court Of Appeals For The Ninth Circuit Denying Petition For Rehearing Dated And Filed June 29, 2000 ..... 69a

Appendix G — Notice Of Supplemental Legal Authority In *Coles, et al. v. Wonder, et al.*, Case No. 1:98 CV 433 ..... 71a

Petitioners respectfully request that a writ of certiorari be issued to review the judgment of the United States Court of Appeals for the Ninth Circuit, entered on May 9, 2000.

OPINIONS BELOW

The opinion and judgment of the Court of Appeals is reported at 212 F.3d 477 and is set forth in Appendix ("App.") A hereto. The denial of rehearing by the Court of Appeals is unreported and is set forth in App. F hereto. The relevant opinions of the district court are unreported and are set forth in Apps. B, C, D and E hereto.

STATEMENT OF JURISDICTION

This Court has jurisdiction to review the judgment of the Court of Appeals by writ of certiorari pursuant to 28 U.S.C. § 1254(1). On September 2, 2000, Justice Sandra Day O'Connor extended the time for filing a petition for a writ of certiorari to October 27, 2000.

STATUTORY PROVISIONS INVOLVED

none

PRELIMINARY STATEMENT

The Ninth Circuit's decision and opinion in this case — the largest reported music infringement judgment involving a single song — creates a striking and important conflict with the governing law in other Circuits. That conflict goes to the heart of the proper division of authority between judge and jury in the recurring infringement cases involving "weak" claims of access (as the Ninth Circuit acknowledged is the

case here).[1] The Ninth Circuit has now resurrected the discredited "slightest doubt" test formulated over fifty years ago in *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), a "standard" which has been repeatedly rejected by the Second Circuit, where it originated, among others. In doing so, the Ninth Circuit has departed from the test applied in other circuits under which the plaintiff must demonstrate that the defendant had a reasonable opportunity (not merely a bare possibility) to have actually heard the work allegedly copied. In retreating to the *Arnstein* rule, the Ninth Circuit has significantly lowered that standard and engendered confusion and unpredictability in a manner that undercuts the primary constitutional purpose of copyright law: "not to reward the labor of individual authors but 'to promote the Progress of Science and useful Arts.' " *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994) This progress is retarded when creative artists have to guess about how individual juries will rule in weak cases rather than being able to look to a uniform standard enforced by judicial gatekeepers. Further, by virtually eliminating any possibility of a grant of summary judgment where there is the slightest doubt, the Ninth Circuit's decision directly conflicts with this Court's decisions which encourage the grant of summary judgment in appropriate cases. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986).

The Ninth Circuit's decision also conflicts with the decision of this Court in *Feist Publications, Inc. v. Rural Telegraph Service Co.*, 499 U.S. 340 (1991), by allowing a jury infringement verdict predicated on substantial similarity of protectible expression to stand based on the mere

1. *Three Boys Music Corporation v. Bolton, et al.*, 212 F.3d 477, 484, 486 (9th Cir. 2000).

combination "of five unprotectible elements," thereby undercutting the important copyright and First Amendment protections that "encourage[ ] authors to build freely on the ideas and information" of predecessors. *Id.* at 349-350.

Finally, in an important ruling of first impression, the Ninth Circuit refused to apply the logical and necessary corollary of its "inverse-ratio rule," thus perpetuating confusion over the proper test to be applied — by judge and jury — in cases where both the evidence of access is weak and the evidence of substantial similarity is questionable (as it was here). Under the Ninth Circuit's opinion, a lesser showing of substantial similarity is required if there is a strong showing of access, but a stronger showing of substantial similarity is not required in a case, like this one, where there was a weak showing of access. The Ninth Circuit's failure to apply the "inverse-ratio rule" symmetrically unfairly skews the law of that Circuit heavily in favor of weak infringement claims, undermines the constitutional rationale establishing the boundaries of copyright protection and chills the creative process of legitimately building on the past without fear of being bankrupted by a weak case of alleged subconscious infringement which a forum-shopped jury may credit.

STATEMENT OF THE CASE

In 1966, The Isley Brothers released a 45 rpm record called "Love Is A Wonderful Thing" (The "Isley Song"). The Isley Song was not released on a record album and plaintiff, Three Boys Music, the owner of the copyright of the Isley Song, could not produce any evidence of record sales, published sheet music, sheet music sales, music publishing income or public performance royalties — the normal indicia of dissemination of a record.

At the time the Isley Song was released in 1966, Michael Bolton and Andrew Goldmark, 13 and 15 years old, respectively, were living in Connecticut. They had no reasonable opportunity to hear the Isley Song. Twenty-six years later, Bolton and Goldmark, accomplished and acclaimed songwriters, wrote a song called "Love Is A Wonderful Thing" (The "Bolton-Goldmark Song"). By that time, there were 129 different songs entitled "Love Is A Wonderful Thing" registered in the Copyright Office. Bolton recorded the Bolton-Goldmark Song, which was released by Sony Music Entertainment Inc. as a single and on an album and which became a huge success. In 1992, plaintiff sued Bolton, Goldmark and others alleging that Bolton and Goldmark *subconsciously* copied five common musical elements which appeared in the Isley Song (and many others) which Bolton and Goldmark allegedly had heard twenty-six years earlier.

Since direct evidence of copying rarely exists, courts have permitted a plaintiff to meet its burden circumstantially by proving that (1) the defendant had access to plaintiff's work and (2) that there is substantial similarity of protectible expression in the two works involved.

As to the first — access — the only evidence of dissemination of the Isley Song in Connecticut, where Bolton and Goldmark were living in 1966, was that it was played a total of, at most, eight times (or a total of about fifteen minutes) on two television shows which originated outside Connecticut. The defendants introduced uncontroverted evidence in the form of contemporaneous TV Guides establishing that neither show aired in Connecticut.[2]

---

2. Plaintiff's other "access" evidence consisted of the testimony of three disk jockeys who testified that they played the Isley Song for a

(Cont'd)

The Isley Song was so obscure that, not only did Bolton and Goldmark testify that they never heard or heard of it, three witnesses who were very familiar with the Isley Brothers and their music — Lamont Dozier, the legendary song writer and producer who was working with the Isley Brothers on other songs at the time the Isley Song was released, Bruce Morrow ("Cousin Brucie"), a New York disc jockey who played other Isley Brothers records in 1966, and Billy Vera, a Rhythm and Blues historian and record collector and an Isley Brothers fan since the 60's — each testified that they never heard or heard of the Isley Song before this litigation.

With respect to the issue of whether the Bolton-Goldmark Song was substantially similar to the Isley Song, plaintiff conceded that the only elements of the Isley Song which bore any similarity to the Bolton-Goldmark Song were five separate and common musical ideas or structures which were not protectible. Plaintiff also conceded that the *arrangement* of those unprotectible elements was not similar. Plaintiff claimed,

---

(Cont'd)

short time on radio stations in Buffalo, Chicago, Philadelphia and New York. Plaintiff also proffered: the testimony of Ronald Isley and his wife that Bolton, in a brief introduction to them before a benefit concert said of Mr. Isley, "I know this guy. I go back with him, I got all of his stuff," and "This man needs no introduction. I know everything he's done"; testimony that Bolton appreciated and sometimes performed, with consent, music previously recorded by certain Black singers — Otis Redding, Smokey Robinson, Marvin Gaye, Ray Charles, Sam Cooke, and others (he did not name the Isley Brothers); and testimony that, while writing the Bolton Goldmark Song, when Goldmark suggested the title, "Love Is A Wonderful Thing," Bolton asked, "isn't there a Marvin Gaye song, 'Some Kind of Wonderful.' " Indeed, there was a Marvin Gaye song which included the lyrics "some kind of wonderful" (not found in the Isley Song) and Bolton had this Marvin Gaye recording in his record collection.

however, that the mere presence in both songs of those otherwise unprotectible elements was sufficient to establish substantial similarity.

In 1994, a jury in the Central District of California returned a verdict for the plaintiff and concluded that 66% of the profits from the single of the Bolton-Goldmark Song and 28% of the profits from the album containing the Bolton-Goldmark Song and 9 other songs, one of which resulted in a Grammy Award for Bolton, were attributable to the infringement. As a result, plaintiff, which could prove no earnings from the Isley Song, received a judgment for $5.4 million.

REASONS FOR GRANTING THE WRIT

I. The Ninth Circuit's Decision Creates a Conflict in the Circuits and with the Decisions of this Court Regarding the Proper Standard for Reviewing a Weak Claim of Access

A. There is a Conflict in the Circuits

Until the Ninth Circuit decision in this case, there was a consensus among federal courts as to the burden a plaintiff must satisfy in order to get to the jury in a copyright infringement case.

> Courts have an important responsibility in copyright cases to monitor the outer limits within which juries may determine reasonably disputed issues of fact. If a case lies beyond those limits, the contrary view of a properly drawn sample of the population, on even of a particular jury, cannot

> be permitted to enlarge (or diminish) the scope of statutory protections enjoyed by a copyright proprietor.

Warner Bros. v. ABC, Inc., 720 F.2d 231, 245 (2d Cir. 1983). The Ninth Circuit's decision in this case has changed all that by rejecting the "reasonable opportunity" standard for access and resurrecting the "slightest doubt" standard set in a fifty-four year old case, *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946), which had long ago been abandoned by every circuit, including the Second Circuit, which created the standard.

Arnstein reversed a summary judgment in favor of the defendant in a music infringement case, despite the plaintiff's highly speculative and fanciful theory that defendant Cole Porter "could have" obtained access to the plaintiff's song by having "stooges" burglarize the plaintiff's apartment. The Second Circuit ruled in *Arnstein* that summary judgment was improper, and a jury verdict was required, if there is the "***slightest doubt***" as to the facts; *i.e.*, unless the defendant "***indubitably*** did not have access to plaintiff's compositions." 154 F.2d at 468-69 (emphasis added). In stark contrast, previous Ninth Circuit law and all other circuits that have considered the issue have recognized that *Arnstein*'s standard of undue and essentially complete deference to the jury's conclusions in infringement actions ***is not*** the law.[3] *See Sid & Marty Krofft Television Productions v. McDonald's Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977) (*Arnstein*'s holding that a trial is required

---

3. While the Ninth Circuit opinion claims to follow prior law, it is impossible to reconcile the result it reached with that standard. Its primary reliance on *Arnstein*, which it described as "the seminal case about musical copyright infringement," 212 F.3d at 481-482, and its analysis compel the conclusion that it departed from the accepted standard.

"when there is the slightest doubt as to the facts has been ***disapproved***."); *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1258 n.5 (2d Cir. 1986) ("The days of *Arnstein v. Porter* . . . are ***behind us***"); *Heyman v. Commerce & Industry Ins. Co.*, 524 F.2d 1317, 1319 (2d Cir. 1975) (*Arnstein*'s approach "has long since been ***jettisoned***"); *Beal v. Lindsay*, 468 F.2d 287, 291 (2d Cir. 1972) ("slightest doubt" rule of *Arnstein* "***no longer*** is good law."); *Ferguson v. National Broadcasting Co., Inc.*, 584 F.2d 111, 114 (5th Cir. 1978) (*Arnstein* "is ***no longer*** good law." (emphasis added).

The Ninth Circuit opinion returns the Ninth Circuit, and the Ninth Circuit alone, to the "slightest doubt" days of *Arnstein* and directly contradicts, and would read out of the law, the reasonable opportunity (as opposed to bare possibility) standard applied in other Circuits.[4] By resurrecting and embracing *Arnstein*, the Ninth Circuit has thus created a conflict in the circuits and uncertainty, confusion and concern in the creative community that artistic freedom will be chilled and restrained as writers fear that they must steer clear of anything they've ever heard or could possibly have heard.

The chilling effect is heightened in cases like this that are admittedly cases of alleged subconscious copying. Here, no claim was ever made that Bolton or Goldmark consciously decided to borrow from the Isley Song. All the more reason to allow the creative process to operate and allow

---

4. *Gaste v. Kaiserman*, 863 F.2d 1061, 1067 (2d Cir. 1988); *Takeall v. Pepsico*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, 14 F.3d 596 (4th Cir. 1993); *Ferguson v. National Broadcasting Company, Inc.*, 584 F.2d 111, 113 (5th Cir. 1978); *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984); *Moore v. Columbia Pictures Industries, Inc.*, 972 F.2d 939, 942 (8th Cir. 1992); *Benson v. Coca-Cola Co.*, 795 F.2d 973, 975 (11th Cir. 1986).

composers to build on prior art without fear that they will be sued for subconsciously "copying" another's work, based on weak and speculative evidence of access.

Moreover, in retreating to the "slightest doubt" days of *Arnstein* (which reversed a summary judgment despite plaintiff's "fantastic" theory of access), and specifically and pointedly predicating its decision on "judicial deference," *Three Boys Music*, 212 F.3d at 482, the Ninth Circuit has lowered the bar a plaintiff must cross and established a new rule of virtual unreviewability of jury verdicts. In so doing, the Ninth Circuit has abrogated the "gatekeeper" responsibility of the district courts to "monitor the outer limits within which juries may determine reasonably disputed issues of fact." *Warner Bros.*, 720 F.2d at 245.[5]

B. There is a Conflict with Decisions of this Court

The Ninth Circuit decision resurrecting *Arnstein* virtually eliminates the possibility of a summary judgment based on lack of access and puts the Ninth Circuit in direct conflict with the decisions of this Court encouraging the grant of summary judgment in appropriate cases. *See, e.g., Anderson*, 477 U.S. at 252 ("mere existence of a scintilla of evidence in support of the plaintiff's position" is insufficient to avoid summary judgment or directed verdict).

* * *

---

5. One plaintiff immediately picked up on the Ninth Circuit decision, filing a Notice of Supplemental Legal Authority in which he argued that the Ninth Circuit "decision further supports [plaintiff's] position that Defendants Stevie Wonder and Motown Record Company are not entitled to summary judgment . . ." *Derrick Coles, et al. v. Stevie Wonder, et al.*, United States District Court, Northern District of Ohio, Eastern Division, Case No. 1:98 CV 433. *See* Appendix A.

The copyright law was embodied in the Constitution "[t]o promote the Progress of Science and useful Arts" which this Court repeatedly has recognized must preserve the delicate balance between the rights of creators, whose original work is entitled to protection, and the rights of others to be free to create new works without fear that they will be sued for having copied prior works. This balance is designed ultimately for the public good, and it necessarily implicates and accommodates substantial First Amendment concerns. *See, e.g., Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The limited scope of the copyright holder's statutory monopoly . . . reflects a balance of competing claims upon the public interest: Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts. The immediate effect of copyright law is to secure a fair return for an author's creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the public good"); *Feist*, 499 U.S. at 349 ("the primary objective of copyright is not to reward the labor of authors but '[t]o promote the Progress of Science and useful Arts. To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.' "). By changing and significantly lowering the standard of access and the burden which must be met by a plaintiff in a copyright case, the Ninth Circuit has ignored these guiding principles and has upset the constitutionally mandated balance. The chilling effect of the Ninth Circuit ruling will have a detrimental impact on expression, creativity, and the continued availability of new works to the public.

II. The Ninth Circuit Opinion on Substantial Similarity of Protectible Expression Conflicts with a Prior Decision of this Court

Proper application of the second element required to prove copying — substantial similarity of protectible expression — must also be applied scrupulously in order to preserve the constitutional balance and to encourage new expression:

> copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship . . . It is the means by which copyright advances the progress of science and art.

Feist, 499 U.S. at 349-50. *See also Sid & Marty Krofft Television Prods.*, 562 F.2d at 1163.

In *Feist*, this Court stated: "Common sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place." 499 U.S. at 345. Yet the Ninth Circuit's affirmance of the jury verdict is based on the presence of but five admittedly uncopyrightable elements in the Isley Song and the Bolton-Goldmark Song.[6] As the court said in its opinion: plaintiff's expert musicologist "testified that the

---

6. The five elements are: the title motif (the portion of the songs with which the words "love is a wonderful thing" are sung), a cadence shift (a change in rhythmic emphasis which occurs in the last statement of a musical selection), two very short instrumental figures (ornamental musical phrases generally played by horns), a verse/chorus relationship (both the verse and chorus begin with the same or similar pitches) and a fade-out coda (a repetition of the same musical phrase at a lower and lower volume) at the end of the song.

two songs shared a combination of five unprotectible elements . . ." 212 F.3d at 485. On that basis, and the concession of defendants expert that he had not found the combination of those five elements in the prior art, the court upheld the verdict.

This result flies in the face of this Court's admonition. As a result, composers of music now fear that by including — consciously or unconsciously — as few as five common unprotectible musical elements in a new composition they run the risk of infringement liability.

III. The Ninth Circuit's Refusal Evenhandedly to Apply the "Inverse-Ratio Rule" Skews the Law so as to Favor Weak Infringement Cases and thereby Undermines the Constitutional Rationale of the Copyright Law

The Ninth Circuit follows the "inverse-ratio rule" under which a lesser showing of substantial similarity is required in cases where there is a strong showing of access[7] — a rule which in and of itself chills expression by reducing the proof required in an infringement case. In this case, the Ninth Circuit compounded the deleterious impact of the rule by refusing to apply the logical corollary and holding that where, as here, evidence on access was weak, greater similarity is required.

---

7. The Second and Eleventh Circuits have expressly rejected the rule. *ARC Music Corp. v. Lee*, F.2d 186 (2d Cir. 1961) (the court referred to the rule as "plaintiff's ingeniously fabricated principal of law"), *Beal v. Paramount Pictures*, 20 F.3d 454 (11th Cir. 1994).

Had the Ninth Circuit properly applied the "inverse-ratio rule" in both directions, it could not have affirmed this jury verdict which was based on both weak evidence of access and a finding of similarity based on the combination of five unprotectible elements. Had the rule been evenhandedly applied, the weakness of the access evidence would have required a higher level of proof of similarity, which was lacking in this case.

The Ninth Circuit's refusal evenhandedly to apply the "inverse-ratio rule" puts a further burden on the freedom of composers to write without fear of being sued. If greater access lessens the burden to show similarity, then surely weaker access should increase this burden. Any other result would further chill the ability of authors and composers to "build freely upon the ideas and information conveyed by a work." *Feist*, 499 U.S. at 349-350.

CONCLUSION

The result in this case creates a critical problem to the creative community which now, after many years of consistent judicial treatment of the issues of access and substantial similarity, faces real uncertainty.

The copyright law was intended to protect freedom of expression and artistic development. In order to fulfill that objective, the rules must be clear and uniformly applied. As this Court said in *Fogerty*, "[b]ecause copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible." 510 U.S. at 527. Just as this Court has fashioned a national rule in defamation cases to protect the rights of

individuals and the press freely to speak and publish, so should the court fashion a national rule in copyright cases to set one standard so that creators are aware of the rules and the federal courts can enforce them so we do not return to a by-gone era in which district courts were deterred from deciding, as a matter of law, that claims resting on mere conjecture should be dismissed.

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

ALAN M. DERSHOWITZ
Counsel of Record
1525 Massachusetts Avenue
Cambridge, MA 02138
(617) 495-4617

ROBERT G. SUGARMAN
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
(212) 310-8184

RUSSELL J. FRACKMAN
MITCHELL SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064
(310) 312-2000

Attorneys for Petitioners

APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT DATED AND FILED MAY 9, 2000

United States Court of Appeals,
Ninth Circuit.

THREE BOYS MUSIC CORPORATION,

Plaintiff-Appellee,

v.

Michael BOLTON, individually and d/b/a Mr. Bolton's Music, Inc.; Andrew Goldmark; Non-Pareil Music, Inc.; Warner-Chappell Music Limited; Warner-Tamerlane Publishing Corp.; WB Music Corp.; and Sony Music Entertainment, Inc.,

Defendants-Appellants.

Nos. 97-55150, 97-55154

Argued and Submitted Oct. 5, 1999
Filed May 9, 2000

* * *

Appeals from the United States District Court for the Central District of California; Lourdes G. Baird, District Judge, Presiding. D.C. No. CV-92-01177 LGB.

Before: FLETCHER, D.W. NELSON, and BRUNETTI, Circuit Judges.

Appendix A

D.W. NELSON, Circuit Judge:

In 1994, a jury found that Michael Bolton's 1991 pop hit, "Love Is a Wonderful Thing," infringed on the copyright of a 1964 Isley Brothers' song of the same name. The district court denied Bolton's motion for a new trial and affirmed the jury's award of $5.4 million.

Bolton, his co-author, Andrew Goldmark, and their record companies ("Sony Music") appeal, arguing that the district court erred in finding that: (1) sufficient evidence supported the jury's finding that the appellants had access to the Isley Brothers' song; (2) sufficient evidence supported the jury's finding that the songs were substantially similar; (3) subject matter jurisdiction existed based on the Isley Brothers registering a complete copy of the song; (4) sufficient evidence supported the jury's attribution of profits to the infringing elements of the song; (5) Sony Music could not deduct its tax liability; and (6) the appellants' motion for a new trial based on newly discovered evidence was unwarranted.

We affirm.

I. BACKGROUND

The Isley Brothers, one of this country's most well-known rhythm and blues groups, have been inducted into the Rock and Roll Hall of Fame. They helped define the soul sound of the 1960s with songs such as "Shout," "Twist and Shout," and "This Old Heart of Mine," and they mastered the funky beats of the 1970s with songs such as "Who's That

Lady," "Fight the Power," and "It's Your Thing." In 1964, the Isley Brothers wrote and recorded "Love is a Wonderful Thing" for United Artists. The Isley Brothers received a copyright for "Love is a Wonderful Thing" from the Register of Copyrights on February 6, 1964. The following year, they switched to the famous Motown label and had three top-100 hits including "This Old Heart of Mine."

Hoping to benefit from the Isley Brothers' Motown success, United Artists released "Love is a Wonderful Thing" in 1966. The song was not released on an album, only on a 45-record as a single. Several industry publications predicted that "Love is a Wonderful Thing" would be a hit — "Cash Box" on August 27, 1966, "Gavin Report" on August 26, 1966, and "Billboard" on September 10, 1966. On September 17, 1966, Billboard listed "Love is a Wonderful Thing" at number 110 in a chart titled "Bubbling Under the Hot 100." The song was never listed on any other Top 100 charts. In 1991, the Isley Brothers' "Love is a Wonderful Thing" was released on compact disc. See Isley Brothers, The Isley Brothers — The Complete UA Sessions, (EMI 1991).

Michael Bolton is a singer/songwriter who gained popularity in the late 1980s and early 1990s by reviving the soul sound of the 1960s. Bolton has orchestrated this soul-music revival in part by covering old songs such as Percy Sledge's "When a Man Love a Woman" and Otis Redding's "(Sittin' on the) Dock of the Bay." Bolton also has written his own hit songs. In early 1990, Bolton and Goldmark wrote a song called "Love Is a Wonderful Thing." Bolton released it as a single in April 1991, and as part of Bolton's album, "Time, Love and Tenderness." Bolton's "Love Is a Wonderful

Thing" finished 1991 at number 49 on Billboard's year-end pop chart.

On February 24, 1992, Three Boys Music Corporation filed a copyright infringement action for damages against the appellants under 17 U.S.C. §§ 101 et seq. (1988). The parties agreed to a trifurcated trial. On April 25, 1994, in the first phase, the jury determined that the appellants had infringed the Isley Brothers' copyright. At the end of second phase five days later, the jury decided that Bolton's "Love Is a Wonderful Thing" accounted for 28 percent of the profits from "Time, Love and Tenderness." The jury also found that 66 percent of the profits from commercial uses of the song could be attributed to the inclusion of infringing elements. On May 9, 1994, the district court entered judgment in favor of the Isley Brothers based on the first two phases.

The deadline for post-trial motions was May 25, 1994. On that day, the appellants filed a motion for judgment as a matter of law and a motion for new trial. The district court denied the motions on August 11, 1994. On June 8, 1994, the appellants filed a second motion for new trial based on newly discovered evidence on the issue of copyright ownership. The district court dismissed this motion as untimely.

On December 5, 1996, the district court adopted the findings of the Special Master's Amended Report about the allocation of damages (third phase). In the final judgment entered against the appellants, the district court ordered Sony Music to pay $4,218,838; Bolton to pay $932,924; Goldmark to pay $220,785; and their music publishing companies to pay $75,900. They timely appealed.

Appendix A

II. DISCUSSION

Proof of copyright infringement is often highly circumstantial, particularly in cases involving music. A copyright plaintiff must prove (1) ownership of the copyright; and (2) infringement — that the defendant copied protected elements of the plaintiff's work. See Smith v. Jackson, 84 F.3d 1213, 1218 (9th Cir.1996) (citation omitted). Absent direct evidence of copying, proof of infringement involves fact-based showings that the defendant had "access" to the plaintiff's work and that the two works are "substantially similar." Id.

Given the difficulty of proving access and substantial similarity, appellate courts have been reluctant to reverse jury verdicts in music cases. See, e.g., id. at 1221 (affirming a jury's verdict for the defendants in a copyright infringement case involving Michael Jackson and other musicians); Gaste v. Kaiserman, 863 F.2d 1061, 1071 (2d Cir.1988) (affirming a jury's damages award against a defendant in a music copyright infringement case). Judge Newman's opinion in Gaste nicely articulated the proper role for an appeals court in reviewing a jury verdict:

> The guiding principle in deciding whether to overturn a jury verdict for insufficiency of the evidence is whether the evidence is such that, without weighing the credibility of the witnesses or otherwise considering the weight of the evidence, there can be but one conclusion as to the verdict that reasonable men could have reached.

Id. at 1066 (internal quotations omitted). In Arnstein v. Porter, the seminal case about musical copyright infringement, Judge Jerome Frank wrote:

> Each of these two issues — copying and improper appropriation — is an issue of fact. If there is a trial, the conclusions on those issues of the trier of the facts — of the judge if he sat without a jury, or of the jury if there was a jury trial — bind this court on appeal, provided the evidence supports those findings, regardless of whether we would ourselves have reached the same conclusions.

Arnstein v. Porter, 154 F.2d 464, 469 (2d Cir.1946).

As a general matter, the standard for reviewing jury verdicts is whether they are supported by "substantial evidence" — that is, such relevant evidence as reasonable minds might accept as adequate to support a conclusion. See Poppell v. City of San Diego, 149 F.3d 951, 962 (9th Cir.1998). The credibility of witnesses is an issue for the jury and is generally not subject to appellate review. See Gilbrook v. City of Westminster, 177 F.3d 839, 856 (9th Cir.), cert. denied, __ U.S. __, 120 S.Ct. 614, 145 L.Ed.2d 509 (1999).

We affirm the jury's verdict in this case in light of the standard of review and copyright law's "guiding principles." Although we will address each of the appellant's arguments in turn, we focus on access because it is the most difficult issue in this case. Our decision is predicated on judicial

deference — finding that the law has been properly applied in this case, viewing the facts most favorably to the appellees, and not substituting our judgment for that of the jury.

A. Access

Proof of access requires "an opportunity to view or to copy plaintiff's work." Sid and Marty Krofft Television Productions, Inc. v. McDonald's Corp., 562 F.2d 1157, 1172 (9th Cir.1977). This is often described as providing a "reasonable opportunity" or "reasonable possibility" of viewing the plaintiff's work. 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright, § 13.02[A], at 13-19 (1999); Jason v. Fonda, 526 F.Supp. 774, 775 (C.D.Cal.1981), aff'd, 698 F.2d 966 (9th Cir.1982). We have defined reasonable access as "more than a 'bare possibility.' " Jason, 698 F.2d at 967. Nimmer has elaborated on our definition: "Of course, reasonable opportunity as here used, does not encompass any bare possibility in the sense that anything is possible. Access may not be inferred through mere speculation or conjecture. There must be a reasonable possibility of viewing the plaintiff's work — not a bare possibility." 4 Nimmer, § 13.02[A], at 13-19. "At times, distinguishing a 'bare' possibility from a 'reasonable' possibility will present a close question." Id. at 13-20.

Circumstantial evidence of reasonable access is proven in one of two ways: (1) a particular chain of events is established between the plaintiff's work and the defendant's access to that work (such as through dealings with a publisher or record company), or (2) the plaintiff's work has been widely disseminated. See 4 Nimmer, § 13.02[A], at

13-20-13-21; 2 Paul Goldstein, Copyright: Principles, Law, and Practice § 8.3.1.1., at 90-91 (1989). Goldstein remarks that in music cases the "typically more successful route to proving access requires the plaintiff to show that its work was widely disseminated through sales of sheet music, records, and radio performances." 2 Goldstein, § 8.3.1.1, at 91. Nimmer, however, cautioned that "[c]oncrete cases will pose difficult judgments as to where along the access spectrum a given exploitation falls." 4 Nimmer, § 13.02[A], at 13-22.

Proof of widespread dissemination is sometimes accompanied by a theory that copyright infringement of a popular song was subconscious. Subconscious copying has been accepted since Learned Hand embraced it in a 1924 music infringement case: "Everything registers somewhere in our memories, and no one can tell what may evoke it. . . . Once it appears that another has in fact used the copyright as the source of this production, he has invaded the author's rights. It is no excuse that in so doing his memory has played him a trick." Fred Fisher, Inc. v. Dillingham, 298 F. 145, 147-48 (S.D.N.Y.1924). In Fred Fisher, Judge Hand found that the similarities between the songs "amount[ed] to identity" and that the infringement had occurred "probably unconsciously, what he had certainly often heard only a short time before." Id. at 147.

In modern cases, however, the theory of subconscious copying has been applied to songs that are more remote in time. ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir.1983) is the most prominent example. In ABKCO, the Second Circuit affirmed a jury's verdict that

former Beatle George Harrison, in writing the song "My Sweet Lord," subconsciously copied The Chiffons' "He's So Fine," which was released six years earlier. See id. at 997, 999. Harrison admitted hearing "He's So Fine" in 1963, when it was number one on the Billboard charts in the United States for five weeks and one of the top 30 hits in England for seven weeks. See id. at 998. The court found: "the evidence, standing alone, 'by no means compels the conclusion that there was access . . . it does not compel the conclusion that there was not.' " Id. (quoting Heim v. Universal Pictures Co., 154 F.2d 480, 487 (2d Cir.1946)). In ABKCO, however, the court found that "the similarity was so striking and where access was found, the remoteness of that access provides no basis for reversal." Id. Furthermore, "the mere lapse of a considerable period of time between the moment of access and the creation of defendant's work does not preclude a finding of copying." 4 Nimmer, § 13.02[A], at 13-20 (citing ABKCO, 722 F.2d at 997-98).

The Isley Brothers' access argument was based on a theory of widespread dissemination and subconscious copying. They presented evidence supporting four principal ways that Bolton and Goldmark could have had access to the Isley Brothers' "Love is a Wonderful Thing":

(1) Bolton grew up listening to groups such as the Isley Brothers and singing their songs. In 1966, Bolton and Goldmark were 13 and 15, respectively, growing up in Connecticut. Bolton testified that he had been listening to rhythm and blues music by black singers since he was 10 or 11, "appreciated a lot of Black singers," and as a youth was the lead singer in a band that performed "covers" of popular

songs by black singers. Bolton also testified that his brother had a "pretty good record collection."

(2) Three disk jockeys testified that the Isley Brothers' song was widely disseminated on radio and television stations where Bolton and Goldmark grew up. First, Jerry Blavitt testified that the Isley Brothers' "Love is a Wonderful Thing" was played five or six times during a 13-week period on the television show, "The Discophonic Scene," which he said aired in Philadelphia, New York, and Hartford-New Haven. Blavitt also testified that he played the song two to three times a week as a disk jockey in Philadelphia and that the station is still playing the song today. Second, Earl Rodney Jones testified that he played the song a minimum of four times a day during an eight to 14 to 24 week period on WVON radio in Chicago, and that the station is still playing the song today. Finally, Jerry Bledsoe testified that he played the song on WUFO radio in Buffalo, and WWRL radio in New York was playing the song in New York in 1967 when he went there. Bledsoe also testified that he played the song twice on a television show, "Soul," which aired in New York and probably in New Haven, Connecticut, where Bolton lived.

(3) Bolton confessed to being a huge fan of the Isley Brothers and a collector of their music. Ronald Isley testified that when Bolton saw Isley at the Lou Rawls United Negro College Fund Benefit concert in 1988, Bolton said, "I know this guy. I go back with him. I have all his stuff." Angela Winbush, Isley's wife, testified about that meeting that Bolton said, "This man needs no introduction. I know everything he's done."

(4) Bolton wondered if he and Goldmark were copying a song by another famous soul singer. Bolton produced a work tape attempting to show that he and Goldmark independently created their version of "Love Is a Wonderful Thing." On that tape of their recording session, Bolton asked Goldmark if the song they were composing was Marvin Gaye's "Some Kind of Wonderful."[1] The district court, in affirming the jury's verdict, wrote about Bolton's Marvin Gaye remark:

> This statement suggests that Bolton was contemplating the possibility that the work he and Goldmark were creating, or at least a portion of it, belonged to someone else, but that Bolton wasn't sure who it belonged to. A reasonable jury can infer that Bolton mistakenly attributed the work to Marvin Gaye, when in reality Bolton was subconsciously drawing on Plaintiff's song.

The appellants contend that the Isley Brothers' theory of access amounts to a "twenty-five-years-after-the-fact-subconscious copying claim." Indeed, this is a more attenuated case of reasonable access and subconscious copying than ABKCO. In this case, the appellants never admitted hearing the Isley Brothers' "Love is a Wonderful Thing." That song never topped the Billboard charts or even made the top 100 for a single week. The song was not released on an album or compact disc until 1991, a year after Bolton

---

1. Marvin Gaye also referred to the song's chorus, "She's some kind of wonderful," in his song, "Too Busy Thinking About My Baby." See Marvin Gaye, Too Busy Thinking About My Baby, on MPG, (Motown 1969).

and Goldmark wrote their song. Nor did the Isley Brothers ever claim that Bolton's and Goldmark's song is so "strikingly similar" to the Isley Brothers' that proof of access is presumed and need not be proven.

Despite the weaknesses of the Isley Brothers' theory of reasonable access, the appellants had a full opportunity to present their case to the jury. Three rhythm and blues experts (including legendary Motown songwriter Lamont Dozier of Holland-Dozier-Holland fame) testified that they never heard of the Isley Brothers' "Love is a Wonderful Thing." Furthermore, Bolton produced copies of "TV Guide" from 1966 suggesting that the television shows playing the song never aired in Connecticut. Bolton also pointed out that 129 songs called "Love is a Wonderful Thing" are registered with the Copyright Office, 85 of them before 1964.

The Isley Brothers' reasonable access arguments are not without merit. Teenagers are generally avid music listeners. It is entirely plausible that two Connecticut teenagers obsessed with rhythm and blues music could remember an Isley Brothers' song that was played on the radio and television for a few weeks, and subconsciously copy it twenty years later. Furthermore, Ronald Isley testified that when they met, Bolton said, "I have all his stuff." Finally, as the district court pointed out, Bolton's remark about Marvin Gaye and "Some Kind of Wonderful" indicates that Bolton believed he may have been copying someone else's song.

Finally, with regard to access, we are mindful of Judge Frank's words of caution in Arnstein v. Porter: "The judge characterized plaintiff's story as 'fantastic'; and in the light

of the references in his opinion to defendant's deposition, the judge obviously accepted the defendant's denial of access and copying. . . . [Y]et plaintiff's credibility, even as to those improbabilities, should be left to the jury." Arnstein, 154 F.2d at 469. In this case, Judge Baird heeded Judge Frank's admonition:

> [T]his Court is not in a position to find that the only conclusion that a reasonable jury could have reached is that Defendants did not have access to Plaintiff's song. One must remember that the issue this Court must address is not whether Plaintiff has proven access by a preponderance of evidence, but whether reasonable minds could find that Defendants had a reasonable opportunity to have heard Plaintiff's song before they created their own song.

Although we might not reach the same conclusion as the jury regarding access, we find that the jury's conclusion about access is supported by substantial evidence. We are not establishing a new standard for access in copyright cases; we are merely saying that we will not disturb the jury's factual and credibility determinations on this issue.

B. Substantial Similarity

Under our case law, substantial similarity is inextricably linked to the issue of access. In what is known as the "inverse ratio rule," we "require a lower standard of proof of substantial similarity when a high degree of access is shown." Smith, 84 F.3d at 1218 (citing Shaw v. Lindheim, 919 F.2d

1353, 1361-62 (9th Cir.1990); Krofft, 562 F.2d at 1172). Furthermore, in the absence of any proof of access, a copyright plaintiff can still make out a case of infringement by showing that the songs were "strikingly similar." See Smith, 84 F.3d at 1220; Baxter v. MCA, Inc., 812 F.2d 421, 423, 424 n. 2 (9th Cir.1987).

Proof of the substantial similarity is satisfied by a two-part test of extrinsic similarity and intrinsic similarity. See Krofft, 562 F.2d at 1164. Initially, the extrinsic test requires that the plaintiff identify concrete elements based on objective criteria. See Smith, 84 F.3d at 1218; Shaw, 919 F.2d at 1356. The extrinsic test often requires analytical dissection of a work and expert testimony. See Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1442 (9th Cir.1994). Once the extrinsic test is satisfied, the factfinder applies the intrinsic test. The intrinsic test is subjective and asks "whether the ordinary, reasonable person would find the total concept and feel of the works to be substantially similar." Pasillas v. McDonald's Corp., 927 F.2d 440, 442 (9th Cir.1991) (internal quotations omitted).

We will not second-guess the jury's application of the intrinsic test. See Krofft, 562 F.2d at 1166 ("Since the intrinsic test for expression is uniquely suited for determination by the trier of fact, this court must be reluctant to reverse it.") (citations omitted). Furthermore, we will not reverse factual determinations regarding the extrinsic test absent a clearly erroneous application of the law. See id. It is well settled that a jury may find a combination of unprotectible elements to be protectible under the extrinsic test because " 'the over-all impact and effect indicate

substantial appropriation.' " Id. at 1169 (quoting Malkin v. Dubinsky, 146 F.Supp. 111, 114 (S.D.N.Y.1956)).

1. Evidence of Substantial Similarity

Bolton and Goldmark argue that there was insufficient evidence of substantial similarity because the Isley Brothers' expert musicologist, Dr. Gerald Eskelin, failed to show that there was copying of a combination of unprotectible elements. On the contrary, Eskelin testified that the two songs shared a combination of five unprotectible elements: (1) the title hook phrase (including the lyric, rhythm, and pitch); (2) the shifted cadence; (3) the instrumental figures; (4) the verse/chorus relationship; and (5) the fade ending. Although the appellants presented testimony from their own expert musicologist, Anthony Ricigliano, he conceded that there were similarities between the two songs and that he had not found the combination of unprotectible elements in the Isley Brothers' song "anywhere in the prior art." The jury heard testimony from both of these experts and "found infringement based on a unique compilation of those elements." We refuse to interfere with the jury's credibility determination, nor do we find that the jury's finding of substantial similarity was clearly erroneous.

2. Independent Creation

Bolton and Goldmark also contend that their witnesses rebutted the Isley Brothers' prima facie case of copyright infringement with evidence of independent creation. By establishing reasonable access and substantial similarity, a copyright plaintiff creates a presumption of copying. The

burden shifts to the defendant to rebut that presumption through proof of independent creation. See Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 721 (9th Cir.1976).

The appellants' case of independent creation hinges on three factors: the work tape demonstrating how Bolton and Goldmark created their song, Bolton and Goldmark's history of songwriting, and testimony that their arranger, Walter Afanasieff, contributed two of five unprotectible elements that they allegedly copied. The jury, however, heard the testimony of Bolton, Goldmark, Afanasieff, and Ricigliano about independent creation. The work tape revealed evidence that Bolton may have subconsciously copied a song that he believed to be written by Marvin Gaye. Bolton and Goldmark's history of songwriting presents no direct evidence about this case. And Afanasieff's contributions to Bolton and Goldmark's song were described by the appellants' own expert as "very common." Once again, we refuse to disturb the jury's determination about independent creation. The substantial evidence of copying based on access and substantial similarity was such that a reasonable juror could reject this defense.

3. Inverse-Ratio Rule

Although this may be a weak case of access and a circumstantial case of substantial similarity, neither issue warrants reversal of the jury's verdict. An amicus brief on behalf of the recording and motion picture industries warns against watering down the requirements for musical copyright infringement. This case presents no such danger.

Appendix A

The Ninth Circuit's inverse-ratio rule requires a lesser showing of substantial similarity if there is a strong showing of access. See Smith, 84 F.3d at 1218. In this case, there was a weak showing of access. We have never held, however, that the inverse ratio rule says a weak showing of access requires a stronger showing of substantial similarity. Nor are we redefining the test of substantial similarity here; we merely find that there was substantial evidence from which the jury could find access and substantial similarity in this case.

C. Sufficiency of the Deposit Copy

The appellants argue that the district court did not have jurisdiction over this case because the Isley Brothers failed to register a complete copy of the song upon which the lawsuit was based. Although the 1909 Copyright Act requires the owner to deposit a "complete copy" of the work with the copyright office, our definition of a "complete copy" is broad and deferential: "Absent intent to defraud and prejudice, inaccuracies in copyright registrations do not bar actions for infringement." Harris v. Emus Records Corp., 734 F.2d 1329, 1335 (9th Cir.1984) (citations omitted).

Bolton and Goldmark argue that in 1964 the Isley Brothers deposited sheet music ("deposit copy") of "Love is a Wonderful Thing" that differed from the recorded version of the song. Furthermore, they claimed that the deposit copy does not include the majority of the musical elements that were part of the infringement claim. At trial, the Isley Brothers' expert, Dr. Eskelin, testified that the deposit copy included all of the song's essential elements such as the title hook, chorus, and pitches. Dr. Eskelin even played the

deposit copy for the jury on the keyboard. We refuse to disturb the jury's finding that the Isley Brothers deposited a "complete copy" because (1) there was no intent to defraud and prejudice and (2) any inaccuracies in the deposit copy were minor and do not bar the infringement action.

D. Attribution of Profits

Sony Music claims that the district court improperly applied an assumption that all profits from Bolton and Goldmark's song go to the Isley Brothers, and that no evidence supported the jury's apportionment of profits. A successful copyright plaintiff is allowed to recover only those profits that are "attributable to infringement." 17 U.S.C. § 504(b) (1994). "In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work." Id. See also Cream Records, Inc. v. Jos. Schlitz Brewing Co., 754 F.2d 826, 828 (9th Cir.1985) (holding that when all profits do not clearly derive from the infringing material, the copyright owner is not entitled to recover all of the profits); Gaste, 863 F.2d at 1070 (finding that where there is "imprecision in the computation of expenses, a court should err on the side of guaranteeing the plaintiff a full recovery"). Thus, the statutory burden of proof lies with Sony Music to prove what percentage of their profits were not attributable to copying the Isley Brothers' "Love is a Wonderful Thing."

Sony Music presented evidence that Bolton's "Love Is a Wonderful Thing" produced only 5-10% of the profits from

his album, "Time, Love and Tenderness," and that the song's infringing elements resulted in only 10-15% of the profits from the song. The Isley Brothers, however, attacked the credibility of one of Sony Music's experts. Furthermore, they presented evidence that Bolton's infringing song was the album's lead single, that it was released 19 days before the album, and that Bolton engaged in telephone promotion of the song. The jury found that 28% of the album's profits derived from the song, and that 66% of the song's profits resulted from infringing elements.

We affirm the jury's apportionment of the profits for several reasons. First, the jury instructions adequately conveyed the burden of proof. Second, the burden of proof was on Sony Music, and the jury chose not to believe Sony Music's experts. Finally, a jury verdict apportioning less than 100% of the profits but more than the percentage estimates of Sony Music's experts does not represent clear error.

E. Deduction of Tax Liability

Sony Music also argues that the district court erred in allowing Bolton and Goldmark, but not Sony Music, to deduct income taxes due to profits from the album. Whether income taxes are considered "deductible expenses" under § 504(b) is an issue of first impression in this circuit. The Supreme Court held that willful infringers could not deduct income taxes, but it left open the possibility that non-willful infringers could deduct their income taxes from the infringing profits. See L.P. Larson, Jr., Co. v. Wm. Wrigley, Jr., Co., 277 U.S. 97, 99-100, 48 S.Ct. 449, 72 L.Ed. 800 (1928). The circuits are split over whether non-willful infringers such

as Bolton, Goldmark, and Sony Music can deduct income taxes from their infringing profits. Compare In Design v. K-Mart Apparel Corp., 13 F.3d 559, 567 (2d Cir.1994) (allowing the deduction of income taxes) with Schnadig Corp. v. Gaines Mfg. Co., Inc., 620 F.2d 1166, 1169-70 (6th Cir.1980) (not allowing the deduction of income taxes).

The Second Circuit allowed the deduction of income taxes because if infringers are liable for pre-tax profits, they may end up paying more money than they ever received. See In Design, 13 F.3d at 567. Under the Second Circuit's rule, the infringer receives a windfall by (1) paying a smaller damages award and (2) deducting the entire, pre-tax award from gross income on a subsequent tax return. The Sixth Circuit rejected the deduction of income taxes because the increased pre-tax profits paid to the copyright holder will be balanced out by an eventual tax refund based on the pre-tax award. See Schnadig, 620 F.2d at 1169-70. Under the Sixth Circuit's rule, the copyright holder receives a windfall by receiving a larger, pre-tax award.

During the third phase of this trial, the district court adopted the findings of the special master's report regarding the deduction of income taxes. The district court followed the Second Circuit rule and allowed Bolton and Goldmark, as non-willful infringers, to deduct the income taxes and management fees that they paid relating to the infringing song. The district court, however, refused to allow Sony Music to deduct its Net Operating Loss Carry-forward (NOL) because the NOL did not have a "concrete financial impact."

We uphold the district court's decision to allow non-willful infringers to deduct income taxes, but not NOL. In

this case, Bolton and Goldmark actually paid income taxes and management fees on the infringing profits. Sony Music, however, never actually paid income taxes on its infringing profits. Rather, Sony Music claimed it offset nearly $1.7 million in taxes on the infringing profits against its parent company's NOL. No court has ever found that NOL is a deductible expense under § 504(b). Furthermore, we find that the district court's distinctions between taxes actually paid and taxes not actually paid was a fair one. Thus, we affirm the district court's calculation of a $4,218,838 damages award against Sony Music.

F. Second New Trial Motion

Finally, Bolton and Goldmark claim that the district court erred in rejecting their second motion for new trial. The district court's denial of a motion for a new trial pursuant to Federal Rule of Civil Procedure 60(b) is reviewed for an abuse of discretion. See Browning-Ferris Indus. v. Kelco Disposal, Inc., 492 U.S. 257, 278, 109 S.Ct. 2909, 106 L.Ed.2d 219 (1989); Scott v. Ross, 140 F.3d 1275, 1281 (9th Cir.1998). The abuse of discretion standard applies particularly when the district court's denial is based on the motion's untimeliness. See E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1294-96 (9th Cir.1992).

Bolton and Goldmark's second motion for a new trial was based on the discovery of new evidence that disputed the Isley Brothers' claim of authorship. A day before the deadline for post-trial motions, the appellees discovered evidence alleging that the Turkcords, a group that played with the Isley Brothers in the mid-1960s, claimed to have

written the 1964 song, "Love is a Wonderful Thing." Bolton and Goldmark did not immediately notify the district court of this new evidence. Instead, fourteen days after the deadline for post-trial motions had passed, they filed an additional motion for new trial. The district court rejected the second motion for new trial as untimely filed.

We affirm the district court's denial of the second motion for new trial because the evidence, if true, goes at most to the weight and credibility of the evidence before the jury. At trial, Ronald Isley claimed to have written the song with the deceased guitar legend, Jimi Hendrix. (As a young man, Hendrix played in the Isley Brothers' band.) The Turkcords' claims of authorship are dubious for several reasons. The Turkcords knew about the re-release of "Love is a Wonderful Thing" by United Artists in 1991, yet they claimed that the Isley Brothers had agreed to share the song's royalties with them only after hearing about the damages award in this case on "Inside Edition." Furthermore, Bolton and Goldmark knew about this new evidence before the deadline for the post-trial motions, yet they did not immediately notify the district court.

Even if the Turkcords' claims of authorship are true, a new trial is not warranted in the interests of justice because the Isley Brothers' copyright ownership is not jeopardized. Registration is prima facie evidence of the validity of a copyright. See 17 U.S.C. § 410(c) (1994). This presumption can be rebutted by the defendant's showing that the plaintiff's work is not original. See North Coast Indus. v. Jason Maxwell, Inc., 972 F.2d 1031, 1033 (9th Cir.1992). North Coast's definition of originality is broad: " 'All that is needed to satisfy both the Constitution and the statute is that the

"author" contributed something more than a "merely trivial" variation, something recognizably "his own." Originality in this context means "little more than a prohibition of actual copying." ' " Id. (quoting Krofft, 562 F.2d at 1163 n. 5 (quoting Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102-03 (2d Cir.1951))). See also Kamar Int'l Inc. v. Russ Berrie and Co., 657 F.2d 1059, 1061 (9th Cir.1981) (employing a broad definition of originality relating to toy stuffed animals).

In this case, the Isley Brothers undoubtedly contributed something original to "Love is a Wonderful Thing." Their proteges, the Turkcords, purportedly wrote the song, then gave the Isley Brothers' permission to record it after the voice of the Turkcords' lead singer allegedly "cracked." Members of the Turkcords allegedly sang back-up on the record. Yet the Turkcords never copyrighted their song. They relied on the Isley Brothers' alleged promise to share the royalties with them.

The district court did not abuse its discretion in rejecting Bolton and Goldmark's second motion for a new trial based on this evidence. The Turkcords' claims of authorship would not have affected the outcome of the case and at most go to the weight and credibility of the evidence. Bolton and Goldmark's second motion was a last-ditch attempt to discredit the jury's verdict. The district court heard all of the evidence in this case, instructed the jury on the applicable law, yet refused to reverse the jury's verdict pursuant to motion for a judgment as a matter of law. Having found that the law was properly applied in this case, we leave the district court's decisions and the jury's credibility determinations undisturbed.

AFFIRMED.

APPENDIX B — FINAL JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED AND FILED DECEMBER 18, 1996

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CV 92-1177 LGB (BQRx)

THREE BOYS MUSIC CORPORATION,

Plaintiff,

v.

MICHAEL BOLTON, et al.

Defendants.

FINAL JUDGMENT

On May 6, 1994, judgment was entered in Phase I of this trifurcated case on the jury's verdict that Defendants had infringed Plaintiff's copyright. On the same day, judgment was also entered in Phase II of this case on the jury's verdict that 28% of the profits derived from the sale of Defendants' album was attributable to the inclusion of the infringing song on the album, and that 66% of the profits from the commercial uses of the infringing song was attributable to the inclusion in that song of elements that infringed Plaintiff's song. Those judgments are hereby incorporated by reference. In Phase III, issues related to Defendants' profits were decided by a Special Master.

Appendix B

Pursuant to this Court's Order entered December 5, 1996 adopting the Special Master's Amended Report with the additional analysis in the Order, the Court hereby ORDERS, ADJUDGES, and DECREES that judgment be and hereby is entered in favor of Plaintiff, THREE BOYS MUSIC CORPORATION, and against Defendants, as to Plaintiff's Complaint.

Therefore, the Court hereby ORDERS that:

1. Defendant SONY MUSIC ENTERTAINMENT, INC. pay Plaintiff $4,218,838, the share of Sony Music's profits from the album and the single to which Plaintiff is entitled.

2. Defendants WARNER-CHAPPELL MUSIC LIMITED; TAMERLANE PUBLISHING CORPORATION; and WB MUSIC CORPORATION pay Plaintiff $75,900, the share of these defendants' profits from the song to which Plaintiff is entitled.

3. Defendant ANDREW GOLDMARK pay Plaintiff $220,785, the share of Goldmark's profits from the song to which Plaintiff is entitled.

4. Defendant MICHAEL BOLTON pay Plaintiff $932,924, the share of Bolton's profits from the album, the single, and publishing to which Plaintiff is entitled.

IT IS SO ORDERED.

Dated: December 18, 1996

s/ Lourdes G. Baird
LOURDES G. BAIRD
United States District Judge

APPENDIX C — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA RE DEFENDANTS' MOTIONS FOR JUDGMENT AS A MATTER OF LAW AND FOR A NEW TRIAL DATED AUGUST 10, 1994 AND FILED AUGUST 11, 1994

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CV 92-1177 LGB (GHKx)

THREE BOYS MUSIC CORP.,

Plaintiff,

v.

MICHAEL BOLTON, et al.,

Defendants.

ORDER RE: DEFENDANTS' MOTIONS FOR JUDGMENT AS A MATTER OF LAW AND FOR A NEW TRIAL

Defendants' motions for judgment as a matter of law and for a new trial came on regularly for hearing before this Court on July 11, 1994. After reviewing the materials submitted by the parties, argument of counsel, and all other matters presented to the Court, it is hereby ORDERED that Defendants' motions are DENIED.

Appendix C

I. Background

Plaintiff, Three Boys Music Corporation, filed this copyright infringement action on February 24, 1992 against Michael Bolton ("Bolton"), Andrew Goldmark ("Goldmark"), and various corporations with which Bolton and Goldmark are affiliated.

In 1990 Bolton and Goldmark wrote a song entitled "Love Is A Wonderful Thing" ("Defendants' song"), which was released in 1991 both as a "single" and as a part of Defendants' album "Time Love And Tenderness." In 1964, Ronald, O'Kelley, and Rudolph Isley (the "Isley Brothers") also wrote a song entitled "Love Is A Wonderful Thing" ("Plaintiff's song") which was released as a single in 1966. The purported copyright in the song was received by Plaintiff from the Register of Copyrights on February 6, 1994. Plaintiff claims that Defendants' song infringes Plaintiff's song.

The first two phases of a three-phase trial proceeding occurred in April of 1994. In the first phase, the jury was asked to determine whether Defendants infringed Plaintiff's purported copyright. On April 25, 1994, the jury made this finding in the affirmative. In the second phase, the jury was called on to determine what percentage of the revenues derived from sales of the album "Time Love And Tenderness" were attributable to the inclusion in that album of the song "Love Is A Wonderful Thing," and what portion of the profits from commercial uses of the song "Love Is A Wonderful Thing" were attributable to the inclusion in that song of elements that infringed Plaintiff's song. On April 29, 1994 the jury found 28% as to the first question, and

66% as to the second question. In the third phase, which is pending, a Special Master will determine issues relating to the profits realized by each of the defendants from the sales of the album and the single.

On May 9, 1994 this Court entered judgment in favor of Plaintiff and against Defendants as to the findings made in the first two phases. On May 11, 1994 the Court sent out a Minute Order which gave Defendants until May 25, 1994 to file post-trial motions. On May 25, 1994 Defendants filed a motion for judgment as a matter of law and a motion for a new trial.[1] These motions are now before the Court. This

---

1. Plaintiff argues that because Defendants filed their motions more than 10 days after the date this court entered judgment against Defendants, Defendants' motions are late and cannot be considered. (J.N.O.V. Opp. at 2; New Trial Opp. at 2.) Ordinarily, such motions must be filed within 10 days after entry of judgment. *See* Federal Rules of Civil Procedure 50(b), 59(b). Furthermore, Rule 6(b) provides that such time limit may not be enlarged by the district court.

However, the May 6, 1994 judgment entered by this court was not a final judgment as damages have still not been determined. *See Liberty Mut. Ins. Co. v. Wetzel*, 424 U.S. 737, 744 (1976); *Balla v. Idaho State Bd. of Corrections*, 869 F.2d 461, 467 (9th Cir. 1989). Furthermore, in *Eady v. Foerder*, 381 F.2d 980 (7th Cir. 1967), the Seventh Circuit held that when a district judge extends the time within which to file a motion for a new trial, and counsel relies to his detriment on such an extension, the "unique circumstances" of such reliance allow the district court to dispose of the motion before it. Despite the debate surrounding *Eady*, *see Varhol v. Nat'l R.R. Passengers Corp.*, 909 F.2d 1557 (7th Cir. 1990), this Court is inclined to follow it. Therefore, the Court will consider Defendants' motions even if they have been filed beyond the time allowed in the Federal Rules.

Court has jurisdiction over this matter pursuant to 28 U.S.C. § 1338(a).

III. Defendants' Motion for Judgment as a Matter of Law

A. Standard

Rule 50(b) of the Federal Rules of Civil Procedure ("Rules") provides:

> Whenever a motion for judgment as a matter of law made at the close of all the evidence is denied or for any reason is not granted,[2] the court is deemed to have submitted the action to the jury subject to a later determination of the legal questions raised by the motion. Such a motion may be renewed by service and filing not later

---

2. A motion for judgment as a matter of law made during the course of trial (i.e., a motion for a directed verdict) is governed by Rule 50(a)(1):

> If during a trial by a jury a party has been fully heard with respect to an issue and there is no legally sufficient evidentiary basis for a reasonable jury to have found for that party with respect to that issue, the court may grant a motion for judgment as a matter of law against that party on any claim . . . that cannot under the controlling law be maintained without a favorable finding on that issue.

Defendants made such motions, and the motions were denied by the Court.

> than 10 days after the entry of judgment. A motion for a new trial may be joined with a renewal of the motion for judgment as a matter of law, or a new trial may be requested in the alternative. If a verdict was returned, the court may, in disposing of the renewed motion, allow the judgment to stand or may reopen the judgment and either order a new trial or direct the entry of judgment as a matter of law. . . .

The standard for passing on the question of whether judgment should be granted as a matter of law is the same whether it arises in the context of a motion for a directed verdict or a motion for judgment notwithstanding the verdict ("J.N.O.V."). *Kaplan v. Burroughs Corp.*, 611 F.2d 286, 290 (9th Cir. 1979), *cert. denied*, 447 U.S. 924 (1980); 9 *Wright & Miller, Federal Practice and Procedure* § 2524 at 541-42 (1971 & Supp. 1993) [hereinafter "*Wright & Miller*"]. The Ninth Circuit has approved a formulation of the standard adopted by the Second Circuit:

> Simply stated, it is whether the evidence is such that, without weighing the credibility of the witnesses or otherwise considering the weight of the evidence, there can be but one conclusion as to the verdict that reasonable men could have reached.

Yeaman v. United States, 584 F.2d 322, 326 (9th Cir. 1978) (quoting *Simblest v. Maynard*, 427 F.2d 1, 4 (2d Cir. 1970)). Therefore, a motion for J.N.O.V. should not be granted "if reasonable minds could differ over the verdict." *Peterson v.*

Kennedy, 771 F.2d 1244 (9th Cir. 1985), *cert. denied*, 475 U.S. 1122 (1986).

Defendants point out that the Ninth Circuit has also employed a "substantial evidence" test under Rule 50:

> In order to benefit from the favorable inferences available under either the directed verdict or j.n.o.v., a party must present "substantial evidence," defined as "evidence as a reasonable mind might accept as adequate to support a conclusion."

Kaplan v. Burroughs Corp., 611 F.2d 286, 290 (9th Cir. 1979), *cert. denied*, 447 U.S. 924 (1980).[3] However, as Professors Wright & Miller have stated, "[i]t is very doubtful that the adjective ['substantial'] adds anything of value, particularly when, as in a leading case,[4] 'substantial' evidence is defined in terms of evidence that would lead reasonable men to different conclusions."

---

3. The Ninth Circuit has also stated that "A district court may grant j.n.o.v. only 'if the evidence permits of only one reasonable conclusion as to the verdict.' " *Olson v. Nat'l Broadcasting Co., Inc.*, 855 F.2d 1446, 1448 (9th Cir. 1988) (quoting *Garter Bare Co. v. Munsingware, Inc.*, 723 F.2d 707, 709 (9th Cir. 1984), *cert. denied*, 469 U.S. 980 (1984)). Although the standard has various formulations, a great number of cases are in essential agreement with the Second Circuit's formulation. *See* 9 *Wright & Miller* § 2524 at 546 n.41.

4. *See Boeing Co. v. Shipman*, 411 F.2d 365, 374 (5th Cir. 1969).

No matter which standard is adopted, it is clear that the Court is not free to weigh the evidence or pass on the credibility of witnesses. *Locricchio v. Legal Services Corp.*, 833 F.2d 1352, 1356 (9th Cir. 1987); *Yeaman*, 584 F.2d at 326; *see also* 9 *Wright & Miller* § 2524 at 543-44. Instead, the Court is to view the evidence most favorably to the party against whom the motion is made, and give that party the benefit of all reasonable inferences from the evidence. *Peterson*, 771 F.2d at 1252; *Wright & Miller* § 2524 at 544-45.

B. Analysis

1. Access

Defendants first argue that Plaintiff failed to prove access as a matter of law. (J.N.O.V. Motion at 4-21.) As the jury was instructed, "[i]n order to establish access, plaintiff must prove that the composers of defendants' song had a reasonable opportunity to have heard plaintiff's song before they created defendants' song." *See* Court's Instruction No. 20;[5] *Meta-Film Associates, Inc. v. MCA, Inc.*, 586 F.Supp. 1346, 1355 (C.D. Cal. 1984); *Jason v. Fonda*, 526 F.Supp. 774 (C.D. Cal. 1981), *aff'd*, 698 F.2d 966 (9th Cir. 1982). Furthermore, if Plaintiff proves that "there is only a bare possibility — as distinguished from a reasonable opportunity — that the composers of defendants' song heard plaintiff's

5. References to jury instructions issued in Phase I of the trial will be to "Court's Instruction No. __." References to jury instructions issued in Phase II of the trial will be to "Court's Instruction No. __ — Phase II."

song before they composed defendants' song," then Plaintiff has not met its burden. *See id.*

The evidence shows that when Plaintiff's song was released in 1966, Bolton and Goldmark, ages thirteen and fifteen respectively, were living in Connecticut. (Tr. at 468-70.)[6] Bolton testified at deposition prior to trial that he loved Black singer's singing since he was probably 10 or 11, and at trial he testified that he "appreciated a lot of Black singers." (Tr. at 468-69.) He also testified that he was the lead singer for bands that did "covers" (i.e., second recordings) of Black singers. (Tr. at 470-71.) Furthermore, Bolton testified that his brother had a "pretty good collection" of Rhythm & Blues ("R&B") records, and that Bolton was familiar to some extent with songs by the Isley Brothers from the 1960s through the 1990s. (Tr. at 475.) In total, a reasonable jury could find that Bolton closely followed the work of Black R&B artists.

Testimony was also introduced regarding the extent to which Plaintiff's song was disseminated. Jerry Bletsoe testified that he came to New York as a Disc Jockey in 1967, and that at that time the stations in New York were playing Plaintiff's song.[7] (Tr. at 1024.) Bletsoe also testified that he played Plaintiff's song twice on a television show called "Soul." When asked whether the program aired in

---

6. References to the transcript of record for Phase I of the trial will be to "Tr. at __." References to the transcript of record for Phase II of the trial will be to "Tr. Phase II at __."

7. Goldmark testified that he listened to New York stations while growing up. (Tr. at 844.)

New Haven Connecticut, Bletsoe stated "I would imagine so, it was on all of the public broadcasting systems throughout the country."[8] (Tr at 1024.) Furthermore, Jerry Blavitt, another disc jockey, testified that he played Plaintiff's song 5 or 6 times in a 13-week period on a television show called "The Discophonic Scene," which, he stated, aired in Philadelphia, New York, and Hartford/ New Haven.[9] (Tr. at 586-89.) He further testified that he aired it on a radio station at least 2 or 3 times a week, and that the station is still playing the song today.[10] (Tr. at 586-89.) Finally, Rodney Jones testified that Plaintiff's song was played a minimum of 4 times a day during either an 8 week or 14 to 24 week period at his radio station WVON, and that it would have been placed in an "oldie" category, which means that it could still be played today. (Tr. at 690-91.)

---

8. Defendants contend that such an assertion is speculative. However, no objection or motion to strike was made by Defendants at trial.

9. When asked how he knew that "The Discophonic Scene" aired in Hartford/New Haven, Blavat stated that the station which produced the show also owned a station in Hartford/New Haven, Connecticut, and that "naturally" the show would be aired at the Connecticut station. (Tr. at 586-87.) Defendants contend that this is a mere speculative assumption. However, no objection or motion to strike this statement was made by Defendants at trial.

10. Defendants have attempted to impeach both Bledsoe's and Blavat's assertions that "Soul" and "The Discophonic Scene" aired in New Haven, Connecticut by introducing issues of the "TV Guide." However, credibility determinations must be resolved by believing the testimony of the nonmoving party's witnesses.

Finally, prior statements made by Bolton himself were introduced which suggest that Bolton may have heard Plaintiff's song prior to recording Defendants' song. For example, Ronald Isley testified that when Bolton saw Isley at the Lou Rawls benefit concert in 1988, Bolton said, "I know this guy. I go back with him, I have all of his stuff." (Tr. at 404.) Also, a work tape used by Bolton and Goldmark in creating their song was introduced into evidence. On this tape, Bolton asks Goldmark whether the song they were creating was "Some Kind Of Wonderful" by Marvin Gaye. This statement suggests that Bolton was contemplating the possibility that the work he and Goldmark were creating, or at least a portion of it, belonged to someone else, but that Bolton wasn't sure who it belonged to. A reasonable jury can infer that Bolton mistakenly attributed the work to Marvin Gaye, when in reality Bolton was subconsciously drawing on Plaintiff's song.

Based on all of the foregoing, this Court is not in a position to find that the only conclusion that a reasonable jury could have reached is that Defendants did not have access to Plaintiff's song. One must remember that the issue this Court must address is not whether Plaintiff has proven access by a preponderance of the evidence, but whether *reasonable minds* could find that Defendants had a *reasonable opportunity* to have heard Plaintiff's song before they created their own song.

2. Substantial Similarity

Defendants next argue that because all of the alleged similarities between Plaintiff's song and Defendants' song

consist of common, unprotectible elements, there can be no substantial similarity of protected expression as a matter of law. (J.N.O.V. Motion at 21-28.)

In *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977), the Ninth Circuit set forth a two part test for determining substantial similarity under copyright law — the extrinsic and intrinsic tests. A finding of copyright infringement is permitted only if plaintiff satisfies both the extrinsic and intrinsic tests. *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990). The extrinsic test is an objective analysis of similarity in ideas and expression which rests upon specific criteria that can be listed or analyzed ("analytic dissection"). *Brown Paper Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475 (9th Cir. 1992), *cert. denied*, __ U.S. __, 113 S.Ct. 198 (1992). The intrinsic test is used to "measure similarity in expressions . . . depending on the response of the ordinary reasonable person." *Krofft*, 562 F.2d at 1164. A court must determine "whether the ordinary person would find the total concept and feel of the works" to be substantially similar. *Pasillas v. McDonald's Corp.*, 927 F.2d 440, 442 (9th Cir. 1991).

Normally, the intrinsic test does not employ analytic dissection. *Krofft*, 562 F.2d at 1164. However, if analytic dissection demonstrates that all similarities in expression arise from the use of common ideas, or are standard elements derived from a common idea, then the intrinsic test may not be satisfied. *Pasillas*, 927 F.2d at 443; *Olson v. National Broadcasting Co., Inc.*, 855 F.2d 1446, 1453 (9th Cir. 1988). Furthermore, in *Shaw v. Lindheim*, 809 F.Supp. 1393, 1403 (C.D. Cal. 1992), this district, citing the Supreme Court's

recent decision in *Feist Publications, Inc. v. Rural Telephone Services Co.*, 499 U.S. 340 (1991), stated that "substantial similarities between unprotected elements . . . cannot be used to find substantial similarities in the protectible expression of two works."

Plaintiff's expert witness, Gerald Eskelin, testified that the infringing elements in Defendants' song consist of: (1) the title-hook phrase, which in turn encompassed the elements of the lyric, the rhythm, and the pitch series; (2) the shifted cadence; (3) the instrumental figures; (4) the verse/chorus relationship; and (5) the fade ending, or "coda." (Tr. at 607.) Eskelin then stated:

> Now, any of these items considered by itself is not unusual. I think it's very important that we understand that right up front. I'm not saying that any one of these individual items is unusual. Some of them are very common. What is unusual, and absolutely extremely unusual, is to have all of these significant elements in two separate pieces. And that is the basis for my testimony here.

(Tr. at 608.) Eskelin further stated:

> . . . [H]ere's the bottom line. All of these elements that we talked about in common between the Isley song and the Bolton-Goldmark song are each individually very common, and if we were just talking about one or two or three of these, we probably would not be here today.
>
> . . . .

Appendix C

> Individually, as I said, all of the individual elements are fairly commonplace, but the combination of elements makes the Isley composition a protectible expression.

(Tr. at 658-59.) Defendants contend that because Plaintiff's expert has admitted that all of the alleged similarities between Plaintiff's song and Defendants' song consist of common elements, there can be no substantial similarity of protected expression as a matter of law.

The cases cited above do in fact support the proposition that common elements are not protected by copyright. However, this proposition does not mean that an artist cannot receive copyright protection in an original compilation of common elements. The *Shaw* court's citation of *Feist* is particularly relevant here. In *Feist* the Supreme Court began by setting forth two "well-established" propositions: "The first is that facts are not copyrightable; the other, that compilations of facts generally are." *Feist*, 499 U.S. at 344. The Court then went on to state:

> There is an undeniable tension between these two propositions. Many compilations consist of nothing but raw data — i.e., wholly factual information not accompanied by any original written expression. On what basis may one claim a copyright in such a work? Common sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place. Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope.

Id. at 345. The Court resolved this tension in the following manner:

> . . . Copyright treats facts and factual compilations in a wholly consistent manner. Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement.

Id. at 350-51.[11] The Court then applied this holding to the facts of the case, and found that an alphabetical listing of addresses in a white pages directory involved no creativity, and therefore did not qualify for copyright protection. *Id.* at 361-64.

Although the facts in *Feist* are different than those in the instant case, the holding nonetheless applies here. Distilling the Court's holding to its essence, the Court found that although copyright protection does not extend to individual uncopyrightable elements of a work, the compilation and arrangement of uncopyrightable elements in an original manner is protected.

---

11. *See also Apple Computer, Inc. v. Microsoft Corp.*, 779 F.Supp. 133, 135-36 (N.D. Cal. 1991) ("Because there ought to be copyright protection for an innovative melding of elements from preexisting works, elements which have been deemed 'unprotectible' should not be eliminated prior to the substantial similarity of expression analysis.").

Appendix C

Eskelin testified that "the combination of elements makes the Isley composition a protectible expression." (Tr. at 659.) Therefore, Plaintiff's expert testimony is not contrary to a finding of copyright infringement.[12] Furthermore, the jury was instructed as follows:

> All of the elements of expression of the ideas contained in a copyrighted song are not necessarily protected by the copyright in the song. For example, the copyright in a song does not protect those elements of expression that were not original to its composers. Also not protected by the copyright in a song are those elements of expression of the song's ideas that are the result of its composers having developed and expressed their ideas in a stock or commonplace manner. Thus, elements of expression in plaintiff's song that result from its composers having employed compositional methods or materials that are stock methods or commonplace materials for the composition of musical works are not protected by the copyright in plaintiff's song and may be freely copied.

---

12. Defendants argue that Eskelin never compared the combination of the elements in Plaintiff's song with the combination of the elements in Defendants' song. (Reply at 15.) However, Eskelin did testify that "[w]hat is unusual, and absolutely extremely unusual, is to have all of these significant elements in two separate pieces." (Tr. at 608.) Furthermore, the jury was free to make such a comparison themselves, and this Court cannot find that no reasonable jury could have found that such a comparison lead to the conclusion of copying.

(Court's Instruction No. 22.) Therefore, regardless of what Eskelin stated, the jury was instructed that stock or commonplace methods or materials are not protectible. Assuming that the individual elements in the two songs were in fact commonplace, this Court can presume that the jury followed the instructions and found infringement based on a unique compilation of those common elements.

Also, despite Eskelin's testimony *supra*, Eskelin testified later in the trial (based on his inspection of prior art in the interim) that many of the alleged similarities "are not as common as I had previously thought." (Tr. at 828-29.) Therefore, Eskelin's testimony is not completely inconsistent with a finding of infringement of individual elements.

Defendants argue that even if the elements in Plaintiff's song are not common, there is no substantial similarity between Plaintiff's song and Defendants' song. (J.N.O.V. Motion at 28-29.) However, Dr. Eskelin testified at length as to the similarities between the two songs. Furthermore, this Court cannot find that a reasonable jury having heard the two songs could only come to the conclusion that the songs are dissimilar.

3. Independent Creation

Defendants argue that even if the jury found that Bolton and Goldmark had access to Plaintiff's song, and that the two songs were substantially similar, Defendants are nonetheless entitled to judgment as a matter of law because the evidence of independent creation far outweighs the evidence of copying. (J.N.O.V. Motion at 29-34.)

Appendix C

If a plaintiff offers proof that the defendant had access to his work and that the two works are substantially similar, then a rebuttable presumption of copying by the defendant arises. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 721 (9th Cir. 1976). A defendant may rebut such a presumption by offering evidence that the song was independently created. *Id.* Therefore, even if Defendants did meet their burden of coming forward with evidence of independent creation, this would only act to remove the presumption of copying. It would then be for the jury to determine based on its consideration of all of the evidence whether Defendants copied Plaintiff's song.

Defendants' evidence of independent creation includes the work tape used by Bolton and Goldmark to compose Defendants' song (J.N.O.V. Motion at 31-32), the prior art of Bolton, Goldmark, and other artists (J.N.O.V. Motion at 32-34), the fact that portions of Defendants' song were created by Walter Afanasieff who testified that he had never heard Plaintiff's song (J.N.O.V. Motion at 34), and Bolton's and Goldmark's history in composing songs. (J.N.O.V. Motion at 34.) This evidence, when compared with Plaintiff's evidence of subconscious copying, is insufficient for this Court to conclude as a matter of law that Defendants must prevail. This Court is not in a position to find that Defendants' evidence is so compelling that no reasonable factfinder could conclude that Defendants copied Plaintiff's song.

4. Complete Copy

Finally, Defendants argue that no reasonable jury could have concluded that Plaintiff deposited a "complete copy" of Plaintiff's song with the Copyright Office.

Appendix C

The Court instructed the jury on this issue as follows:

> In order to register a song with the Copyright Office, the applicable Copyright law requires that a "complete copy" of the song be deposited with the Copyright Office at the time of registration.
>
> In order for the copy of Plaintiff's musical composition submitted with the Copyright Office to be sufficiently "complete," the copy must consist of the entire composition, as opposed to a mere outline or summary. Trivial or technical omissions from the composition on deposit do not render the deposit incomplete.

(Court's Instruction No. 15.) Defendants argue that the melodic settings of the title phrases in the deposit copy are different than the melodic settings of the title phrases in Plaintiff's song. (J.N.O.V. Motion at 35.) Furthermore, Defendants introduce testimony from Eskelin that the deposit copy does not include an introduction, instrumental figures, or a coda; elements which are included in Plaintiff's song. (Tr. 759-61.)[13]

However, Eskelin also testified that:

> I looked at the deposit copy, and it has the essential elements of the song, "Love Is A

13. Defendants also argue that Eskelin admitted that 16 of the 29 pitches are different in the chorus of the deposit copy than the chorus of the recording. (Reply at 18-19.) However, the transcript is confusing on this point (*see* Tr. at 759), and does not necessarily support such a proposition.

> Wonderful Thing" as recorded. There are differences in details, but that doesn't matter. There are always differences of details, but the essence of the song on the deposit copy is there and that is what was recorded on the album.

(Tr. at 662.) Furthermore, when asked what was included in the deposit copy, Eskelin stated: "Verses, chorus, lyrics, chorus music, pitches. It's all there." (Tr. at 662.)

This Court would be going beyond its province for it to conclude that a reasonable jury could not find, either based on Eskelin's testimony or based on its own comparison of the deposit copy with Plaintiff's song, that the deposit copy was sufficiently complete.

C. Conclusion

For all of these reasons, this Court hereby ORDERS Defendants' motion for judgment as a matter of law is DENIED.

IV. Defendants' Motion for a New Trial

A. Generally

Federal Rule 59(c) provides:

> A new trial may be granted to all or any of the parties and on all or part of the issues . . . in an action in which there has been a trial by jury, for any of the reasons for which new trials have

heretofore been granted in actions at law in the Courts of the United States.

The ultimate goal in granting a motion for a new trial is to prevent a miscarriage of justice. 11 *Wright & Miller* § 2803, at 31. Such a motion may be made on several grounds, including the insufficiency of the evidence and the misconduct of counsel. *See* Central District of California Local Rule 15.1 (1993), Defendants have moved on both of these grounds.

B. Insufficiency of the Evidence

1. Standard

A stringent standard applies when the motion is based on the insufficiency of the evidence. *Venegas v. Wagner*, 831 F.2d 1514, 1519 (9th Cir. 1987); *Digidyne Corp. v. Data General Corp.*, 734 F.2d 1336, 1347 (9th Cir. 1984), *cert. denied*, 473 U.S. 908 (1985). A motion for a new trial may be granted on this ground "only if the verdict is against the 'great weight' of the evidence or 'it is quite clear that the jury has reached a seriously erroneous result.' " *Id.* (quoting *Digidyne*, 734 F.2d at 1347); *see also William Inglis & Sons Baking Co. v. ITT Continental Baking Co., Inc.*, 668 F.2d 1014, 1027 (9th Cir. 1981), *cert. denied*, 459 U.S. 825 (1982) ("[A] new trial may be ordered by the district court if, in its opinion, the jury's verdict was clearly contrary to the weight of the evidence.").

Nonetheless, the standard for granting a new trial is lower than that for granting a motion for judgment as a matter of

law. For example, the existence of substantial evidence does not prevent a court from granting a motion for a new trial if the verdict is against the clear weight of the evidence. *Landes Constr. Co., Inc. v. Royal Bank of Canada*, 833 F.2d 1365, 1371 (9th Cir. 1987). Furthermore, the district judge may weigh the evidence and assess the credibility of the witnesses, and need not view the evidence from the perspective most favorable to the prevailing party. *Id.* A judge should balance her duty to prevent a miscarriage of justice with a decent respect for the collective wisdom of the jury.[14] *Id.* (quoting *Wright & Miller* § 2806, at 49). Ultimately, the decision whether to grant a new trial rests in the trial judge's sound discretion. *Murphy v. City of Long Beach*, 914 F.2d 183, 186 (9th Cir. 1990); *Natural Resources, Inc. v. Wineberg*, 349 F.2d 685, 691 (9th Cir. 1965), *cert. denied*, 382 U.S. 1010 (1966).

---

14. Defendants argue that this Court should give the jury no deference in light of its alleged clearly erroneous findings on the issues of independent creation and apportionment, as well as in light of the questions it submitted to the Court. (New Trial Motion at 43-45.) However, even assuming that the jury's verdict on some issues was against the clear weight of the evidence, no authority supports the proposition that this should impugn its findings on all other issues. The time-honored policy of giving deference to the jury's findings militates against such a rule. As to the questions the jury submitted to the Court, these questions suggest that the jury was struggling over its verdict, and do not, as Defendants argue, show that the jury was incapable or unwilling to perform its function.

In any event, the ultimate issue is whether upholding the jury's verdict would be a miscarriage of justice. In making such decision, this Court will consider all of the circumstances, and will not follow any hard and fast rules.

2. Access

Defendants first argue that the jury's verdict on the issue of access is against the clear weight of the evidence. Defendants contend that the testimony of Jerry Bletsoe and Jerry Blavitt, discussed *supra*, is insubstantial and speculative (New Trial Motion at 4-5), that the evidence of live performances of Plaintiff's song is weak (New Trial Motion at 6-7), that Ronald Isley's account of Bolton's statements at the Lou Rawls Benefit is inconsistent with Isley's answer to an interrogatory (New Trial Motion at 8), and that the evidence of lack of access[15] is substantial. (New Trial Motion at 9-11.)

However, after considering and weighing all of the evidence presented by both parties, this Court does not find that a jury's verdict that Bolton and Goldmark had a "reasonable opportunity" to have heard plaintiff's song before they created their own song is against the "great weight" of the evidence, or that it is quite clear that the jury has reached a "seriously erroneous" result. To uphold the jury's finding on this issue would not result in a miscarriage of justice.

3. Substantial Similarity

Next, Defendants argue that the jury's verdict finding substantial similarity of protectible expression is against the

---

15. This evidence consists mostly of testimony by Bolton, Goldmark, Lamont Dozier, Bruce Morrow, and Billy Vera that they had never heard Plaintiff's song until the time of trial.

clear weight of the evidence. (New Trial Motion at 11-15.) Defendants argument is directed at the credibility of Plaintiff's expert witness, Gerald Eskelin, as compared to Defendants' expert witness, D. Anthony Ricigliano. At most, Defendants have shown that Eskelin's testimony was not flawless. However, they have not given this Court a basis to completely ignore his testimony, and this Court cannot conclude that believing his testimony over the testimony of Ricigliano would result in a miscarriage of justice.

Eskelin testified at length as to similarities between Defendants' song and Plaintiff's song. Furthermore, the jury had an opportunity to make its own comparison of the two songs independent of any expert testimony. Therefore, the evidence of substantial similarity is not against the clear weight of the evidence.

4. Copying

Defendants next argue that in light of Defendants' evidence of independent creation, the jury's finding that Defendants copied Plaintiff's song is against the great weight of the evidence. (New Trial Motion at 15-20.) Like their argument in connection with substantial similarity, Defendants' argument here is directed at the credibility of Eskelin's testimony.

Again, the testimony of Eskelin was not so inconsistent or otherwise untrustworthy that this Court should ignore it in its entirety. Furthermore, Defendants had the opportunity at trial to thoroughly cross-examine Eskelin and challenge his testimony. Taking into consideration Eskelin's testimony

as to the similarities between the Plaintiff's song and Defendants' song, and also considering the substance of the songs themselves (regardless of the testimony of the experts), this Court concludes that the jury's verdict on the issue of copying is not against the great weight of the evidence.

5. Apportionment

Defendants next argue that they are entitled to a new trial with respect to the apportionment of profits. Once the jury returned a verdict finding that Defendants copied Plaintiff's song, Phase II of the trial was held at which the jury was given the following instruction:

> The owner of the copyright in a song that has been infringed is entitled to recover those profits of the defendants that are attributable to defendants' use of material from the copyrighted song which infringes its copyright.
>
> Therefore, in dealing with the profits realized from the sales of a record album which includes both a song that infringes a copyrighted song and several songs that are not infringing, you must first determine in percentage terms what portion of the profits from the sales of that album were exclusively attributable to the inclusion of the infringing song. In making this determination you should consider what portion of the profits from the sale of the album were attributable to the inclusion of songs other than the song "Love is a Wonderful Thing," and other factors that may

have motivated members of the public to buy the album.

Once you have determined the percentage of the profits attributable exclusively to the inclusion of the song "Love is a Wonderful Thing" on the "Time, Love and Tenderness" album, you must then make a second finding. This finding requires you determine what percentage of the profits from commercial uses of Defendant's song is attributable to the inclusion in that song of elements that infringe Plaintiff's song, and what percentage is attributable to noninfringing elements and other factors.

It is Defendant's burden to prove the portion of their profits that is not attributable to the inclusion of Defendants' song on the album and the portion of their profits that is not attributable to the inclusion in Defendants' song of the elements which you have found infringed Plaintiff's song. However, Defendants are not required to make such proof with certainty. All that is required of Defendants is that they present proof that reasonably approximates what portion of their profits was not attributable to the inclusion of Defendants' song on the "Time Love and Tenderness" album, and what portion of their profits was not attributable to the inclusion in Defendants' song of the elements that you have found infringe the copyright in Plaintiff's song.

Appendix C

(Court's Instruction No. 15 — Phase II.) As to the first questions presented to the jury (regarding the album), the jury returned a verdict of 28%. As to the second question (regarding the single), the jury returned a verdict of 66%.

a. The Album

Defendants first argue that the jury's finding that the song "Love Is A Wonderful Thing" was responsible for 28% of the profits from sales of the album "Time Love And Tenderness" is against the clear weight of the evidence. (Motion at 21-24.) Defendants argue that this figure should have been between 5 and 10 percent, as the only evidence adduced on this issue supported such a figure.

Defendants called Richard Kudolla, the Senior Vice President of Sony Music, who testified that based on Bolton's popularity, the success of other songs on the album, advertising expenses incurred to promote the album, as well as other factors, he was of the opinion that the song "Love Is A Wonderful Thing" was responsible for between 5 and 10 percent of the profits of the album "Time Love And Tenderness." (Tr. Phase II at 37.) Defendants indicate that in response, Plaintiff elicited evidence that the single "Love Is A Wonderful Thing" was released 19 days before the album was released and that Bolton had a telephone promotion of the single on March 4, 1991. Defendants argue that the remainder of Plaintiff's case consisted of an attack on the credibility of Kudolla. Defendants therefore contend that Plaintiff's evidence does not support the verdict.

Once the jury found that Defendants copied Plaintiff's song, the burden was on Defendants "to prove his or her

deductible expenses and the elements of profit attributable to factors other than the copyrighted work." 17 U.S.C.A. § 504(b) (1977). Therefore, there is an assumption that 100% of the profits from sales of the album "Time Love And Tenderness" were attributable to the song "Love Is A Wonderful Thing," and it is Defendants' burden to defeat that assumption with evidence or profit not attributable to the song. Therefore, the fact that Plaintiff did not come forward with evidence tying sales of the album to the song does not, alone, mean that Defendants' theory as to how much profits were attributable to the song must be accepted.

The Court finds that based on a consideration of all of the evidence presented, the jury's finding that 28% of the profits from the album "Time Love And Tenderness" were attributable to the song "Love Is A Wonderful Thing" is not against the clear weight of the evidence.

b. The Single

The jury found that the percentage of profits from commercial uses of Defendant's song attributable to the inclusion in that song of elements that infringe Plaintiff's song was 66%. Defendants argue that this finding is also against the great weight of the evidence. (New Trial Motion at 24-27.)

Defendants state that they offered evidence from Steve Kingston, Program Director of WHTZ in New Jersey, that in his opinion 10 to 15 percent of the success of the song was attributable to the title motif and that none of the other allegedly infringing elements contributed more than a

de minimis amount. (New Trial Motion at 25.) Defendants then indicate that Plaintiff argued that 100% of the profits from commercial uses of Defendant's song were attributable to the inclusion in that song of elements that infringe Plaintiff's song, but offered no evidence to support such an assertion.

However, as discussed *supra*, the issue is not how much evidence Plaintiff has presented to bring the percentage up to 66 percent, but how much evidence Defendants have presented to bring the percentage down to 10 to 15 percent. Once a defendant has been found liable for copyright infringement, the burden does not rest on the plaintiff to prove that the commercial success of the defendant's song was attributable infringing elements of that song. Instead, the burden is on the defendant to prove that the commercial success of the song was attributable to noninfringing elements. *See* 17 U.S.C.A. § 504(b) (1977).

This Court finds that Kingston's testimony was not so convincing and compelling that a jury had no choice but to reach the result of 10 to 15 percent. On the other hand, a jury finding of 100 percent would clearly be beyond the pale. Where in between these percentages the true percentage lies is an extremely complicated question of fact that is not capable of ready determination. Wherever such true figure lies, this Court does not find that 66 percent is so far off base as to be against the great weight of the evidence.

6. Complete Copy

Defendants next argue that the jury's finding that Plaintiff deposited a "complete copy" of Plaintiff's song

with the Copyright Office is against the great weight of the evidence. (New Trial Motion at 27.) In support of such argument, Defendants incorporate by reference the argument they made in connection with this issue in their motion for judgment as a matter of law. Likewise, for the reasons discussed in section III.B.4., *supra*, this Court finds that the jury's finding on this issue is not against the great weight of the evidence.

7. Conclusion

For all of these reasons, the Court finds that the verdict is not against the great weight of the evidence and that it is not clear that the jury has reached a seriously erroneous result. Therefore, the court hereby ORDERS that Defendants' motion for a new trial based on insufficiency of the evidence is DENIED.

C. Misconduct of Counsel

1. Standard

Defendants argue that the misconduct of Plaintiff's counsel warrants a new trial. (Motion at 27-43.) To be granted a new trial on this ground, the " 'flavor of misconduct must sufficiently permeate an entire proceeding to provide conviction that the jury was influenced by passion and prejudice in reaching its verdict.' " *Kehr v. Smith Barney, Harris Upham & Co., Inc.*, 736 F.2d 1283, 1286 (9th Cir. 1984) (quoting *Standard Oil Co. of California v. Perkins*, 347 F.2d 379, 388 (9th Cir. 1965)). In making its decision, a trial court should consider whether the misconduct occurred

only during the argument phase of trial, whether the misconduct was isolated rather than persistent, whether the moving party objected to the misconduct and moved for a new trial, and whether the award of damages was excessive. *Cooper v. Firestone Tire & Rubber Co.*, 945 F.2d 1103, 1107 (9th Cir. 1991); *Kehr*, 736 F.2d at 1286. "Most motions for a new trial on this ground are denied, either because the conduct complained of, under the circumstances, was not misconduct, or because it was not prejudicial, or because it was not objected to, or because any prejudice was cured by the instructions of the court." 11 *Wright & Miller*, § 2809, at 61-64.

Counsel's failure to object to misconduct at trial precludes such an objection in a motion for a new trial. *See United States v. Socony-Vacuum Oil Co.*, 310 U.S. 150 (1940); *Barzelis v. Kulikowski*, 418 F.2d 869 (9th Cir. 1969) ("[W]e have not yet so far abandoned the adversary system, at least in civil cases, that counsel can sit by without objecting when [an improper] argument is made, raise the question for the first time after the argument or on a motion for a new trial, and, after the motion is denied, expect us to reverse on appeal."). In *Socony-Vacuum*, the Supreme Court held that counsel, during closing argument, "cannot as a rule remain silent, interpose no objections, and after a verdict has been returned seize for the first time on the point that the comments to the jury were improper and prejudicial." *Socony-Vacuum*, 310 U.S. at 238-39. "Only in extraordinary situations, in order to prevent a 'plain miscarriage of justice,' will a revieving court reverse a judgment based upon errors not objected to at trial." *Lange v. Schultz*, 627 F.2d 122, 127 (8th Cir. 1980); *see also Socony-Vacuum*, 310 U.S. at 239.

Appendix C

2. Access

Defendants first argue that counsel for Plaintiff repeatedly mischaracterized the evidence regarding access in his opening and closing arguments. (New Trial Motion at 28-29, 33-37.) However, counsel for Defendants never objected to these alleged mischaracterizations, and never moved for a mistrial on this ground. Furthermore, the alleged misconduct consists mostly of argumentative inferences drawn by Plaintiff's counsel which do not so mischaracterize the evidence as to warrant a new trial.

For example, Defendants state that Plaintiff's counsel repeatedly argued that Bolton testified that "the song thereafter wrote itself." (New Trial Motion at 34-35.) Bolton's actual testimony was that "the song in itself in a way writes itself." (Tr. at 923.) Defendants argue that "[o]bviously, Mr. Bolton never said, in words, substance, or effect, 'the song thereafter wrote itself.' " (New Trial Motion at 34-35.) However, if counsel in closing argument was held to the exact words, substance, and effect of testimony elicited during trial, argument would be useless, and new trials would be the norm. Furthermore, Defendants had the obligation to object to any alleged mischaracterizations, and had the right to explain them during their own closing argument.

Defendants also argue that Plaintiff's counsel repeatedly and deliberately asked witnesses misleading questions to produce a favorable result. (New Trial Motion at 29-33.) Again, counsel for Defendants rarely objected to the questioning now complained of, and when their was an objection, the objection was sustained and the question either

suppressed or modified. A party cannot sit on his rights at trial with the expectation that if he wins, he wins, but if he loses, then he will simply assert his rights after trial and eventually get a second bite at the apple. *See Barzelis, supra.* Furthermore, the questioning complained was not so prejudicial as to require a new trial.

3. Race

Defendants next argue that Plaintiff injected race into the proceedings by making a frivolous *Batson* challenge before trial, and by repeatedly asking questions and making argument about how Bolton emulated Black musicians. (New Trial Motion at 37-39.) Defendants suggest that the motive for doing this was to "introduce an inappropriate racial component into this case." (New Trial Motion at 39.) However, "injecting race" into a trial cannot per se prejudice a party. Defendants have offered no theory as to how Plaintiff's conduct adversely affected the jury such that allowing the verdict to stand would amount to a miscarriage of justice. Whether Bolton emulated Black artists goes directly to the issue of access, and Plaintiff's introduction of evidence to that effect is certainly not grounds for a new trial.

4. Deposit Copy

Defendants next argue that Plaintiff's counsel's examination of Plaintiff's expert, Gerald Eskelin, on the issue of whether Plaintiff had submitted a complete copy of its song with the Copyright Office was prejudicial. (New Trial Motion at 39.) Defendants argue that Plaintiff's counsel

asked Eskelin whether the copy of Plaintiff's song on file with the Copyright Office was "sufficiently complete to identify" Plaintiff's song. Defendants assert that this was not an issue for the jury to decide, and therefore the jury was misled. Although the ultimate issue for the jury to decide was whether the copy of Plaintiff's song on file with the Copyright Office was "complete," this does not mean that the question Eskelin answered was irrelevant. Whether the copy of the song on file with the Copyright Office was "sufficiently complete to identify" Plaintiff's song may have been helpful to the jury in determining whether a "complete" copy was on file. For this reason, the Court overruled Defendants' objection when this question was posed to Eskelin. (Tr. at 793.)

Defendants also argue that Plaintiff's counsel's argument to the jury on the issue of whether Plaintiff had submitted a complete copy of its song with the Copyright Office was prejudicial. (New Trial Motion at 39.) Defendants assert that during Plaintiff's counsel's closing argument in rebuttal, when it was too late for Defendants to respond, Plaintiff's counsel argued that the Copyright Office never rejected Plaintiff's song as incomplete, and that therefore it must have been complete. Defendants argue that the Copyright Office's acceptance of materials has nothing to do with whether or not they are complete. Although Defendants did not have a chance to argue in response, they did have a chance to object at trial. They failed to do so (Tr. at 1511), and such failure precludes them from now seeking a new trial.

Appendix C

5. Apportionment

Finally, Defendants argue that during his closing argument in the apportionment phase of the trial, Plaintiff's counsel repeatedly misstated facts and attempted to put evidence in the record without any factual basis. (New Trial Motion at 40-43.) Defendants point to only two statements made by Plaintiff's counsel during closing to which Defendants objected. First, Plaintiff's counsel argued that Defendants "spent $500,000 advertising to get that song going so that it would make the album." (Tr. Phase II at 149.) Second Plaintiff's counsel stated that no album since "Time Love And Tenderness" has sold what "Time Love And Tenderness" sold. (Tr. Phase II at 150.) Neither of these statements had any foundation in the evidence, both were objected to, and both objections were sustained. In fact, the Court admonished Plaintiff's counsel at side bar after the second statement was made. (Tr. at 150-51.) Although it was error for Plaintiff to make such statements, such error was not so prejudicial as to require a new trial.

Defendants also argue that Plaintiff's counsel sought to appeal to the jury's sympathies by referring to Defendants as "big corporate defendants." (New Trial Motion at 41-43.) However, Defendants themselves employed the same strategy by arguing in closing that Bolton does countless hours of work for charitable causes, that he is the chairman of various charitable foundations, that he is dedicated to helping children, and that he cares for two daughters who live with him. (Tr. at 1482, 1504.) In any event, Plaintiff's counsel only referred to Defendants as "the corporate defendants" and did not expressly appeal to the jury's

sympathies in this regard.[16] (Tr. at 142-45.) Furthermore, the statements were not objected to and were not prejudicial. Therefore, they do not offer grounds for a new trial.

6. Conclusion

For all of these reasons, the Court finds that any misconduct on the part of Plaintiff's counsel did not sufficiently permeate the trial to provide conviction that the jury was influenced by passion and prejudice in reaching its verdict. *See Kehr, supra.* Therefore, the Court hereby ORDERS that Defendants' motion for a new trial based on misconduct of counsel is DENIED.

SO ORDERED.

Dated: Aug. 10, 1994

s/ Lourdes G. Baird
LOURDES G. BAIRD
United States District Judge

---

16. The authority cited by Defendants is therefore distinguishable. *See Draper v. Airco, Inc.*, 580 F.2d 91, 95 (3d Cir. 1978) (granting a new trial because counsel for Plaintiff "repeatedly made reference to the wealth of the defendants in contrast to the relative poverty of the plaintiff."); *City of Cleveland v. Peter Kiewit Sons' Co.*, 624 F.2d 749, 756 (6th Cir. 1980) ("[C]ounsel for the [plaintiff] almost continuously sought to plant the seeds in the minds of the jurors that [the defendant] was a very large corporation with international operations."); *Brownlee v. United Fidelity Life Ins. Co.*, 117 F.R.D. 383, 387 (S.D. Miss. 1987), *aff'd*, 854 F.2d 1319 (5th Cir. 1988) (granting motion for new trial where statements made by counsel for plaintiff in closing included: "A corporation is created by man. It aint got no heart thumping in its big hairy chest. He hasn't got no soul worried about getting to heaven. It aint worried about hell itself.").

APPENDIX D — ORDER AND JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA RE PHASE II DATED AND FILED APRIL 29, 1994, AND DATED AND FILED MAY 6, 1994, RESPECTIVELY

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CV 92-1177 LGB (GHKx)

THREE BOYS MUSIC CORP.,

Plaintiff,

v.

MICHAEL BOLTON, et al.,

Defendants.

ORDER RE: PHASE II
SPECIAL VERDICT FORM

The Court hereby issues the following Special Verdict Form for Phase II of the trial:

We, the jury in the above entitled action, find the following special verdict on the following questions submitted to us:

Appendix D

Question 1

What percentage of the profits derived from the sale of the album "Time, Love and Tenderness" is attributable to the inclusion of the song "Love Is A Wonderful Thing" on that album?

28%

Question 2

What percentage of the profits from commercial uses of the song "Love is a Wonderful Thing" is attributable to the inclusion in that song of elements that infringed Plaintiff's song?

66%

After you have answered both questions 1 and 2, have the jury Foreperson sign and date this Special Verdict Form, and inform the Court that you have reached a verdict.

Dated: 4-29-94

s/ [illegible]
Jury Foreperson

Appendix D

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CASE NUMBER
CV92-1177-LGB(GHKx)

THREE BOYS MUSIC CORPORATION

Plaintiff

vs

MICHAEL BOLTON, et al

Defendant

(PHASE II)
JUDGMENT ON THE VERDICT
(For Plaintiff)

(ORDER RE: SPECIAL VERDICT FORMS)

This cause having been tried by the Court and a Jury, before the Honorable LOURDES G. BAIRD, Judge presiding, and the issues having been duly tried and the Jury having duly rendered it's verdict; now, therefore, pursuant to the verdict,

IT IS ORDERED, ADJUDGED AND DECREED that the plaintiff(s) Three Boys Music Corporation have and recover of and from the defendant(s) Michael Bolton; Andrew Goldmark; Nonpareil Music; Warner-Chappell

Appendix D

Music, Ltd.; Warner-Tamerland Publishing Corporation; WB Music Corporation; and Sony Music Entertainment, Inc. the sum of an amount to be determined by a Special Master in Phase III of this action. (Attached Special Interrogatories are incorporated herein by reference.)

Clerk
United States District Court

Dated: May 6, 1994

By: s/ K. J. Kirksey
Deputy Clerk
K. J. Kirksey

APPENDIX E — CIVIL MINUTES OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA RE DENIAL OF DEFENDANTS' MOTIONS FOR JUDGMENT AS A MATTER OF LAW AND A NEW TRIAL DATED MARCH 1, 1993

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES-GENERAL

Case No.: CV-92-1177 LGB (GHKx)

Date: March 1, 1993

Title: *Three Boys Music v. Bolton, et. al.*

DOCKET ENTRY

PRESENT: Hon. Lourdes G. Baird, United States District Judge

* * *

PROCEEDINGS: Defendants' Motion for Summary Judgment

The Ninth Circuit has stated that

> Because . . . the act of copying is rarely witnessed, copying is ordinarily established indirectly. The plaintiff demonstrates that the defendant had access to the copyrighted items, and that the

> defendant's product is substantially similar to plaintiff's work. Once this is done, the burden shifts to the defendant to prove his work was not copied, but independently created.

Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059, 1062 (9th Cir. 1981). Defendants have moved for summary judgment on the grounds that there is no dispute of material fact as to whether Plaintiff may demonstrate access in this case.

Defendants have provided ample evidence to demonstrate that Plaintiff's song was not a commercial success. Moreover, Defendants have submitted the declarations of Defendants Bolton and Goldmark that neither ever heard Plaintiff's song until after they had composed their song.

Rule 56(c) of the Federal Rules of Civil Procedure provides that a court shall grant a motion for summary judgment if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law."

Whether a fact is material is determined by looking to the substantive law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). Facts are deemed "material" if a dispute over them "might affect the outcome of the suit under the governing law . . ." *Id.*

Appendix E

The moving party has the burden of demonstrating the absence of a genuine issue of fact for trial. *Id.* at 256.

A "genuine issue" of material fact exists only when the nonmoving party makes a sufficient showing to establish an essential element to that party's case, and on which that party would bear the burden of proof at trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor. *Anderson*, 477 U.S. at 255 (citing *Adickes v. S. H. Kress and Company*, 398 U.S. 144 (1970)).

The Court sustains each of Defendants' evidentiary objections (to the Declaration of Ronald Isley, ¶ 6, page 3, line 13 and 14; to the Declaration of Ronald Isley, ¶ 6, page 3, lines 10 through 12; to Exhibit A of the Declaration of Jerry Blavitt; and, to the Declaration of Gerry Bletsoe, ¶ 7, page 2, lines 25 and 26).

Even so, Plaintiff's opposition satisfies the burden set out by the foregoing precedents. In particular, the work tape of Bolton and Goldmark's songwriting session raises a triable issue of fact as to whether Bolton and Goldmark knew that "Love is a Wonderful Thing" was a 1960s R&B song, even though Bolton incorrectly guessed the artist to be Marvin Gaye. It is not for this court to decide precisely what Bolton might have meant by the comment, "What is that, is that some kind of wonderful, is that a Marvin Gaye song?"

Furthermore, Plaintiff has introduced sufficient evidence to raise a triable issue of fact as to the level of dissemination of Plaintiff's song in the 1960s and afterwards.

Appendix E

Finally, there is a triable issue of fact as to whether Bolton had heard Plaintiff's song. The Court recognizes that Bolton has declared that he had not heard Plaintiff's song prior to the composition of his song. However, in light of the fact that cross-examination of Bolton at his deposition demonstrated his wide knowledge of 1960s R&B music, in light of the fact that Bolton was a teenage band member in the 1960s and music has been his principal occupation ever since, and in light of the comments on the work tape, the Court must conclude that it would be improper to assess Bolton's credibility for purposes of a motion for summary judgment.

Therefore, Defendants' motion for summary judgment is DENIED.

Deputy Clerk s/ KJK

APPENDIX F — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED JUNE 29, 2000

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

NOS. 97-55150
97-55154
97-55198
97-56032
DC NO. CV-92-01177 LGB

THREE BOYS MUSIC CORPORATION,

Plaintiff-Appellee,

vs.

MICHAEL BOLTON, individually and d/b/a MR. BOLTON'S MUSIC, INC., ANDREW GOLDMARK, NON-PAREIL MUSIC, INC., WARNER-CHAPPELL MUSIC LIMITED, WARNER-TAMERLANE PUBLISHING CORP., WB MUSIC CORP. and SONY MUSIC ENTERTAINMENT, INC.

Defendants-Appellants.

ORDER

Before: B. FLETCHER, D.W. NELSON, and BRUNETTI, Circuit Judges.

Appendix F

The members of the panel that decided this case voted unanimously to deny the petition for rehearing and to deny the petition for rehearing en banc.

The full court has been advised of the petition for rehearing en banc and no active judge has requested a vote on whether to rehear the matter en banc. (Fed. R. App. P. 35.)

The petition for rehearing, and the petition for rehearing en banc, are DENIED.

APPENDIX G — NOTICE OF SUPPLEMENTAL LEGAL AUTHORITY IN *COLES, et al. v. WONDER, et al.*, CASE NO. 1:98 CV 433

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

CASE NO. 1:98 CV 433

JUDGE SOLOMON OLIVER, JR.
MAGISTRATE JUDGE HEMANN

DERRICK COLES, et al.,

Plaintiffs,

vs.

STEVIE WONDER, et al.,

Defendants.

NOTICE OF SUPPLEMENTAL LEGAL AUTHORITY

Intervenor Plaintiff, Gwendolyn Daniles ("Daniles"), by and through counsel, hereby notifies the Court of a recent decision rendered by the United States Ninth District Court of Appeals in the case, *Three Boys Music Corporation v. Michael Bolton, et al.* (May 9, 2000), 2000 U.S. App. LEXIS 9163. A copy of this decision is appended hereto as Exhibit A.

Appendix G

There, the U.S. Court of Appeals for the Ninth Circuit affirmed a jury verdict in favor of the Isley Brothers and against songwriters, Michael Bolton and Andrew Goldmark. The action concerned the Isley Brothers' song, *Love Is A Wonderful Thing*. This decision further supports Daniles' position arguing that Defendants, Stevie Wonder and Motown Record Company, are not entitled to summary judgment for the following reasons:

1. As in this case, both songs shared the same title (*Love Is A Wonderful Thing*);

2. As in this case, both songs shared the same title hook phrase (including the lyric, rhythm and pitch);

3. As in this case, both songs shared the same verse/ chorus relationship;

4. As in this case, the Plaintiffs submitted evidence of an earlier creation date for their song;

5. As in this case, Defendants Bolton and Goldmark denied ever hearing the Isley Brothers' version of *Love Is A Wonderful Thing*, prior to the release of their song.

6. As in this case, Defendants Bolton and Goldmark argued that because there were in excess of 100 songs registered with the Copyright Office sharing the same title, such evidence revealed that the songs were not "substantially similar."

7. As in this case, Plaintiffs established substantial similarity of the two songs by utilizing the two-part test of an "extrinsic similarity" (analytical dissection of the musical works by the use of an expert witness) and "intrinsic similarity" (subjective, ordinary person test);

8. As in this case, Plaintiffs established that Defendants Bolton and Goldmark had access to their song by showing that there was merely a "reasonable possibility" of copying and that access may have been "subconscious";

9. As in this case, Plaintiffs never claimed that the *entirety* of their work, *Love Is A Wonderful Thing*, was strikingly similar to a musical work created by Bolton and Goldmark;

10. As in this case, Defendants Bolton and Goldmark attacked the sufficiency of the Isley Brothers' copyright deposit material by arguing that the material differed from the recorded version of the song; (The Court, however, rejected this claim, ruling that the term "complete copy" as used in the Copyright Act is broadly construed, and that "absent intent to defraud and prejudice, inaccuracies in copyright registrations do not bar actions for infringement" citing *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984);[1]

---

1. On May 5, 2000, Coles received a Form PA, Registration No. PAU2-417-200, from the United States Copyright Office, which

(Cont'd)

Accordingly, Intervenor Plaintiff respectfully requests the Court issue an order denying Defendants' Motion for Summary Judgment.

Respectfully submitted,

s/ Peter A. Hessler
Peter A. Hessler (0005594)
Christopher A. Holecak (0040840)
WEGMAN, HESSLER,
VANDERBURG & OTOOLE
6055 Rockside Woods Blvd., #200
Cleveland, OH 44131
(216) 642-3342

Roger G. Emerson (0037731)
John Skeriotis (0069263)
Key Building, Suite 830
159 South Main Street
Akron, OH 44308
(330) 535-9999

Attorneys for Intervenor
Plaintiff, Gwendolyn Daniles

(Cont'd)
serves to register a 1973 recording of his work *For Your Love*, and to identify a basic registration number PAU1-414-969, dated September 4, 1990, to be a derivative work of his 1973 recording of the song entitled, *For Your Love*.

Supreme Court, U.S.
FILED
DEC

No. 00-689

IN THE

Supreme Court of the United States

MICHAEL BOLTON, *et al.*,
Petitioners,

v.

THREE BOYS MUSIC CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

JOHN P. MCNICHOLAS
MCNICHOLAS & MCNICHOLAS
10866 Wilshire Blvd.
Los Angeles, CA 90024

CHARLES M. STERN
KATTEN, MUCHIN & ZAVIS
1999 Avenue of the Stars
Los Angeles, CA 90067

RICHARD G. TARANTO
(Counsel of Record)
FARR & TARANTO
1850 M Street, NW
Washington, DC 20036
(202) 775-0184

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
STATEMENT	1
ARGUMENT	5
A. Access	5
B. Substantial Similarity	11
C. Inverse Ratio Rule	14
CONCLUSION	16

TABLE OF AUTHORITIES

Cases	Page
Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986)	6
ARC Music Corp. v. Lee, 296 F.2d 186 (2d Cir. 1961)	15
Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946)	5, 6, 7
Beal v. Paramount Pictures Corp., 20 F.3d 454 (11th Cir. 1994)	16
Benson v. Coca-Cola Co., 795 F.2d 973 (11th Cir. 1986)	10
Celotex Corp. v. Catrett, 477 U.S. 317 (1986)	6
Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991)	11, 12
Ferguson v. NBC, Inc., 584 F.2d 111 (5th Cir. 1978)	10
Gaste v. Kaiserman, 863 F.2d 1061 (2d Cir. 1988)	9
Hooks v. Clark County School Dist., 228 F.3d 1036 (9th Cir. 2000)	6
Lucht v. Molalla River School Dist., 225 F.3d 1023 (9th Cir. 2000)	6
Moore v. Columbia Pictures Ind., Inc., 972 F.2d 939 (8th Cir. 1992)	9
Rand v. Rowland, 154 F.3d 952 (9th Cir. 1998)	6
Reese v. Jefferson School Dist. No. 14J, 208 F.3d 736 (9th Cir. 2000)	6
Reeves v. Sanderson Plumbing Prods., Inc., 120 S. Ct. 2097 (2000)	7
Selle v. Gibb, 741 F.2d 896 (7th Cir. 1984)	10
Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977)	6, 7
Smith v. Jackson, 84 F.3d 1213 (9th Cir. 1996)	16

TABLE OF AUTHORITIES—Continued

Page

Takeall v. Pepsico, Inc., 809 F. Supp. 19 (D. Md. 1992), *aff'd*, 14 F.3d 596 (4th Cir. 1993)..... 10

Other Materials

II P. Goldstein, *Copyright* (2d ed.)..... 7, 9

4 M. Nimmer & D. Nimmer, *Nimmer on Copyright* 7, 8

IN THE

Supreme Court of the United States

No. 00-689

MICHAEL BOLTON, *et al.*,
Petitioners,

v.

THREE BOYS MUSIC CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

STATEMENT

A jury in 1994 found petitioners liable for copyright infringement. The district court denied petitioners' post-trial motions and entered judgment on the verdict. The Ninth Circuit, likewise declining to disturb the jury verdict, affirmed.

1. This case involves a song entitled "Love Is A Wonderful Thing" written and recorded by the Isley Brothers in the mid-1960s. By 1966, the Isley Brothers were already a prominent rhythm and blues group, having just released a string of hit songs with the Motown record label. Seeking to capitalize on that success, their earlier label, United Artists, released the already-recorded "Love Is A Wonderful Thing" as a 45 rpm single. Major industry publications called

attention to the song—the copyright in which is held by respondent. Pet. App. 3a.[1]

The song almost made Top 100 charts. *Id.* According to disc jockeys playing records at the time, the song was played repeatedly during 1966 and 1967 on radio stations in New York, Philadelphia, Buffalo, and Chicago—in the last of which it was played intensely, at least four times a day during a 2-6 month period. *Id.* at 10a. It would reasonably be inferred that many other radio stations across the country played the song as well. (Information from the royalty organization, Broadcast Music Inc. (BMI), was unavailable, because BMI, through no fault of the Isley Brothers, failed to register the song. Tr. 400-02.) The song was even performed on widely broadcast television shows in 1966 or 1967, certainly on New York stations and, according to disputed testimony, probably also on New Haven/Hartford stations. Pet. App. 10a, 12a. The song, eventually included in a 1991 Isley Brothers compact disc, became "part of the catalog" (Tr. 589) and has continued to be played on radio stations to the present day. Pet. App. 10a.

In 1966, respondents Michael Bolton (then age 13) and Andrew Goldmark (then age 15) were teenagers living in southwest Connecticut (New Haven and New Canaan, respectively). *See id.* at 9a. Bolton testified that his brother had a good record collection and, more importantly, that he himself "had been listening to rhythm and blues music by black singers since he was 10 or 11, 'appreciated a lot of Black singers,' and as a youth was the lead singer in a band that performed 'covers' of popular songs by black singers." *Id.* at 9a-10a. Indeed, throughout his career, from the 1960s into the 1990s, Bolton continued to perform "covers" of rhythm and blues songs written and previously recorded by

---

[1] Pursuant to Rule 29.6 of the Rules of this Court, respondent states that it has no parent companies and that no publicly held company owns ten percent or more of its stock.

black artists like the Isley Brothers. *Id.* at 3a. Bolton, who acknowledged "some" familiarity with Isley Brothers songs on the witness stand (Tr. 475), had previously admitted to being a fan of their music. Ronald Isley testified that, at a concert in 1988, Bolton said, "'I know this guy. I go back with him. I have all his stuff.'" Pet. App. 10a. Isley's wife "testified about that meeting that Bolton said, 'This man needs no introduction. I know everything he's done.'" *Id.*

In 1990, Bolton and Goldmark wrote a song also called "Love Is A Wonderful Thing," which, with considerable success, they released as a single and on an album in 1991. *Id.* at 3a-4a. A tape of their working session developing the song contains a remark by Bolton wondering whether "the song they were composing was Marvin Gaye's 'Some Kind Of Wonderful.'" *Id.* at 11a (footnote omitted). At trial, Bolton answered affirmatively to the question whether, according to the tape, "there [was] a question in your mind as to whether or not what you have just sung, what you and Mr. Goldmark have just done might belong to someone else." Tr. 947-48.

2. Respondent sued for damages for copyright infringement in 1992. Pet. App. 4a. The jury, which listened to the Isley Brothers song and the Bolton/Goldmark song several times, heard testimony about all the relevant infringement issues, including the issue of petitioners' access to the Isley Brothers song and the issue of the substantial similarity of elements in the Bolton/Goldmark song to original expression in the Isley Brothers song. Specifically, expert musicologists testified about the substantial similarity—in the lyric, pitch, and rhythm of the two songs' critical "title hook" phrases, as well as in other features of the popular songs. Pet. App. 15a.[2]

---

[2] "Hook" is a phrase from Tin Pan Alley that "means that portion of the song that the listener tends to remember. And when he hears it again, to recognize it. He says, 'Oh, there's that song again.'" Tr. 608. In both the

The instructions under which the case was tried are not challenged by petitioners. The jury was instructed that, if it found "that there is only a bare possibility as distinguished from a reasonable opportunity that the composers of defendants' song heard plaintiff's song before they composed defendants' song," it "must conclude that access has not been established." Tr. 1426. The jury then answered "yes" to the question, "Did either Michael Bolton or Andrew Goldmark have 'access' to Plaintiff's song?" C.A. Supp. E.R. 63. The jury also found "substantial similarity" of both ideas and expression. *Id.* at 63-64. And the jury, even after finding access and substantial similarity, separately found that those findings warranted the inference that copying in fact occurred. *Id.* at 65. The jury thus found infringement. Pet. App. 4a.

The same jury, after hearing additional evidence, then determined the extent of the unauthorized borrowing from the Isley Brothers song. It found that the infringement produced 66 percent of the profits from the Bolton/Goldmark song, which in turn produced 28 percent of the profits from the album on which it appeared. *Id.* The actual accounting of the profits was performed subsequently by a special master and the district court. *Id.* The damages ($5.4 million) were also allocated among the several petitioners, the lion's share being borne by petitioner Sony Music. *Id.* The district court subsequently denied petitioners' post-trial motions. *Id.* at 26a-60a.

3. The court of appeals affirmed. *Id.* at 1a-23a. The court of appeals recited the accepted standards not only for proving copying through "fact-based showings that the defendant had 'access' to the plaintiff's work and that the two works are 'substantially similar'" (*id.* at 5a) but also for appellate

---

Isley Brothers and Bolton/Goldmark songs, the "hook" phrase is also the title of the song.

review of a jury verdict for substantial evidence (*id.* at 6a). Applying those standards, the court held that there was sufficient evidence to support a reasonable finding of access (*id.* at 7a-13a), that there was sufficient evidence to support a reasonable finding of substantial similarity and to permit rejection of the claim of independent creation (*id.* at 13a-16a), and that no showing of similarity greater than "substantial similarity" was required to offset a "weak" but nevertheless sufficient showing of access (*id.* at 16a-17a). The court of appeals also rejected petitioners' other attacks on the judgment, which it accordingly affirmed. *Id.* at 17a-23a.

ARGUMENT

Petitioners' three questions, the first of which rests on a misdescription of the court of appeals' decision, are all meritless. Although they claim otherwise, petitioners have not identified any ruling by the court of appeals that conflicts with any decision of another court of appeals or of this Court. The court's decision is a correct application of established legal standards to the facts of this case. The petition should be denied.

A. Access

Petitioners' principal contention is that the court of appeals "resurrected the discredited 'slightest doubt' test formulated over fifty years ago in *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946)" and "departed from the test applied in other circuits under which the plaintiff must demonstrate that the defendant had a reasonable opportunity (not merely a bare possibility) to have actually heard the work allegedly copied." Pet. 2; *id.* at 7. This two-part contention, however, rests on a two-part distortion of the Ninth Circuit's opinion. As is obvious on the face of the opinion, the Ninth Circuit did not embrace (indeed, even mention) the "slightest doubt" test or reject the "reasonable opportunity" standard in favor of a

"bare possibility" standard. The conflicts alleged by petitioners are thus imaginary.

As to *Arnstein*: a simple reading of the opinion below puts beyond question that the Ninth Circuit nowhere quoted, cited, or relied on the "slightest doubt" standard that *Arnstein* long ago used for the *general Rule 56 standard for summary judgment* (which is not tied to copyright cases specifically). Contrary to petitioners' accusation (Pet. 2, 9-10), neither in the decision in this case nor elsewhere has the Ninth Circuit rejected the now-governing summary-judgment standards of *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986), and *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), in favor of the old *Arnstein* standard.[3] It is therefore beside the point that, as petitioners say (Pet. 7-8), courts outside the Ninth Circuit have repudiated the old *Arnstein* "slightest doubt" standard, for the Ninth Circuit has not adopted that standard; indeed, even before *Celotex* and *Liberty Lobby*, the Ninth Circuit expressly acknowledged the disapproval of that aspect of *Arnstein*. *See Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977) ("*Arnstein*'s alternative holding that summary judgment may not be granted when there is the slightest doubt as to the facts has been disapproved.").

The Ninth Circuit did rely on aspects of *Arnstein* other than the "slightest doubt" standard. Pet. App. 6a (copying and improper appropriation are issues of fact; sufficiency review on appeal is not de novo redetermination of facts), 12a-13a (credibility is left to jury). But that reliance is unobjectionable and of no moment here. Those aspects of *Arnstein*—

---

[3] The Ninth Circuit regularly invokes and follows the *Celotex/Liberty Lobby* standard in preference to the older "slightest doubt" standard. *See, e.g., Hooks v. Clark County School Dist.*, 228 F.3d 1036, 1038 (9th Cir. 2000); *Lucht v. Molalla River School Dist.*, 225 F.3d 1023, 1025 (9th Cir. 2000); *Reese v. Jefferson School Dist. No. 14J*, 208 F.3d 736, 738 (9th Cir. 2000); *Rand v. Rowland*, 154 F.3d 952, 956-57 (9th Cir. 1998).

substantive copyright-law principles and the usual cautions about second-guessing credibility and other factual determinations in reviewing sufficiency of the evidence—are not the subject of any repudiation by other courts and remain perfectly good law. Not one of petitioners' authorities cited as creating a conflict (Pet. 7-8 & n.4) disagrees with any of those aspects of *Arnstein*, which petitioners themselves do not openly question. The cited substantive copyright standards remain valid (*see Sid & Marty Krofft Television*, 562 F.2d at 1165),[4] as do the principles of appellate review of jury determinations, which are fully in accord with the settled standards most recently restated by this Court in *Reeves v. Sanderson Plumbing Prods., Inc.*, 120 S. Ct. 2097, 2110 (2000).[5] Nothing about *Arnstein*, therefore, or the standards

---

[4] *Arnstein*'s pronouncements on copyright law are still cited as authoritative by the leading treatises. *See, e.g.*, II P. Goldstein, *Copyright* § 7.2.1 at 7:7 nn.4, 5, 7:13 n.18 (2d ed.); 4 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.02 at 13-15 n.3, 13-18 n.13, 13-20 n.15.

[5] "[T]he standard for granting summary judgment 'mirrors' the standard for judgment as a matter of law, such that 'the inquiry under each is the same.' *Anderson v. Liberty Lobby*, 477 U.S. at 250-51; *see also Celotex*, 477 U.S. at 323. It therefore follows that, in entertaining a motion for judgment as a matter of law, the court should review all of the evidence in the record.

"In doing so, however, the court must draw all reasonable inferences in favor of the nonmoving party, and it may not make credibility determinations or weigh the evidence. *Lytle v. Household Mfg., Inc.*, 494 U.S. 545, 554-555(1990); *Liberty Lobby*, *supra*, at 254; *Continental Ore Co. v. Union Carbide & Carbon Corp.*, 370 U.S. 690, 696, n. 6 (1962). 'Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge.' *Liberty Lobby*, *supra*, at 255. Thus, although the court should review the record as a whole, it must disregard all evidence favorable to the moving party that the jury is not required to believe. See [9A C. Wright & A. Miller, *Federal Practice and Procedure* § 2529, at 299 (2d ed. 1995)]. That is, the court should give credence to the evidence favoring the nonmovant as well as that 'evidence supporting the moving party that is uncontradicted and unimpeached, at least to the extent that

announced or applied by the Ninth Circuit for review of the jury verdict in this case, justifies further review by this Court.

As to the "reasonable opportunity" standard, petitioners again rely on a mischaracterization of the court of appeals' opinion. Although petitioners say otherwise (without citation), the court of appeals nowhere rejected, doubted, or questioned the very distinction—requiring a "reasonable opportunity" for access, and deeming a "bare possibility" insufficient (Pet. 2)—petitioners urge. To the contrary, that is the precise standard the court of appeals expressly embraced. Pet. App. 7a ("Proof of access requires . . . a 'reasonable opportunity' or 'reasonable possibility' of viewing the plaintiff's work. We have defined reasonable access as 'more than a "bare possibility." ' " (citations omitted)).

It is thus fanciful to say that the court of appeals adopted incorrect legal standards governing proof of copying through access (along with substantial similarity). There is no dispute here that, because copying must be proved indirectly in most situations, a jury is permitted (not required) to infer copying from proof that the defendants had a reasonable opportunity to hear the copyrighted work and that the defendants' work contains expression substantially similar to protectible elements of the copyrighted work, with copying not having to be conscious to be actionable. Pet. App. 5a, 7a-8a.[6] Nor is

---

that evidence comes from disinterested witnesses.' *Id.*, at 300." 120 S. Ct. at 2110 (internal citations shortened).

[6] These long-established principles rest on the recognition, as explained in the Ninth Circuit by the Recording Industry Association of America (RIAA), that "[a]ctual copying . . . is frequently not susceptible of effective direct proof" and, because "creation is a solitary endeavor, . . . in most instances it would be impossible to prove that the defendant had *actually* been exposed to plaintiff's work," so courts have long recognized the permissibility of inferring access from "evidence of the defendant's 'reasonable opportunity' to have viewed or heard plaintiff's work." C.A. *Amicus* Br. of RIAA at 5; *see* 4 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.01[B] at 13-10 to -11, 13-12 ("generally not possible to

there any dispute that these normal means of indirectly proving access and copying are well-recognized to raise simply "'a question of probabilities'" (C.A. *Amicus* Br. of RIAA at 6; *see* II P. Goldstein, *Copyright* § 7.2.1 at 7:7 (2d ed.)), with different factual situations requiring case-specific judgments about whether reasonable minds could find access (and copying) to have been more likely than not. *Id.* § 7.2.1.1 at 7:8, 7:10 ("virtually all decisions in which access is an issue turn on inferential proofs," with a "factual middle ground" between "two poles of probability" where access is certain or speculative). Not surprisingly, then, petitioners do not even attempt to articulate any different legal principles from those adopted by the court of appeals.

With no legal principles at issue, petitioners' complaint reduces to a challenge to the application of correctly articulated legal principles to the facts of this particular case. This type of challenge generally does not merit review, and this case is no exception. Petitioners do not even make an effort to show that other judicial decisions about access, on their facts, conflict with the holding here. Petitioners do not discuss the facts of other decisions at all. Pet. 7-8. Even as they cite some decisions *allowing* findings of access (*e.g.*, *Moore v. Columbia Pictures Ind., Inc.*, 972 F.2d 939, 942-45 (8th Cir. 1992); *Gaste v. Kaiserman*, 863 F.2d 1061, 1066-67 (2d Cir. 1988)), they cite no decision that rejects a finding of access as a matter of law on facts like those here or, indeed,

---

establish copying as a factual matter by direct evidence"; "copying is ordinarily established indirectly by the plaintiff's proof of access and 'substantial' similarity" (footnotes omitted)), 13-13 ("copying as a factual matter typically depends on proof of access and probative similarity," though "such evidence does not require the trier of fact to find copying" (footnotes omitted)); *id.* § 13.02[A] at 13-15 (because "it is often impossible for a plaintiff to offer direct evidence that defendant . . . actually viewed or had knowledge of plaintiff's work," sufficient to prove "opportunity to view" to permit inference of copying); II P. Goldstein, *Copyright* § 7.2 at 7:6, § 7.2.1.1 at 7:8 to :10 (2d ed.).

where there was substantial distribution through broadcast media at all.[7]

On the facts in this case, the court of appeals correctly held, a reasonable jury could find access (and copying). There was ample evidence to show that the Isley Brothers song, put out by a hot group, "was widely disseminated on radio and television stations where Bolton and Goldmark grew up" (Pet. App. 10a) and never ceased be played on ("oldies") radio stations up to the present (*id.*). With respect to the likelihood of access, petitioners Bolton and Goldmark were anything but average members of the public. Not just teenagers, they were teenagers with an avid interest in music—and not just any music, but the specific genre of music at issue: "rhythm and blues music by black singers."

---

[7] Only four of the authorities cited by petitioners in discussing *Arnstein* (Pet. 7-8), besides *Moore* and *Gaste* (noted in text), involve contested access rulings. *Ferguson v. NBC, Inc.*, 584 F.2d 111, 112 (5th Cir. 1978), involved an "unpublished composition [that] was never performed in this country; nor was it sold, offered for sale, or circulated to the general public." *Selle v. Gibb*, 741 F.2d 896, 898, 902 (7th Cir. 1984), likewise involved a copyrighted song that was never broadcast, but merely played two or three times in Chicago and sent (on tape and on paper) to several recording and publishing companies; "the availability of [plaintiff's] song, as shown by the evidence, was virtually *de minimis*." *Benson v. Coca-Cola Co.*, 795 F.2d 973, 975 (11th Cir. 1986), also involved a song never broadcast, but performed at a small number of "nightclubs, hotels and restaurants" that the accused infringers never visited at the relevant times. Nor was broadcast material at issue in *Takeall v. Pepsico, Inc.*, 809 F. Supp. 19 (D. Md. 1992), *aff'd*, 14 F.3d 596 (4th Cir. 1993), which involved a slogan that the plaintiff author, an "obscure . . . Maryland ventriloquist" (*id.* at 19), had performed "mostly in connection with his crusade against drugs . . . primarily in a limited market and before limited audiences, such as schools and Job Corps centers, to which there is absolutely no evidence that the [defendants] had any access at all" (*id.* at 21). Thus, none of the decisions involved broadcast works; in addition, all involved obscure plaintiffs, in contrast to already well-known performing artists, like the Isley Brothers, whose works are likely to be sought out by substantial numbers of fans of the particular style.

Id. at 9a. And Bolton particularly was not just an avid listener: he was part of a band that actually performed music—music of this very type, "popular songs by black singers." *Id.* at 9a-10a. Bolton, moreover, later "confessed to being a huge fan of the Isley Brothers and a collector of their music," stating of Ronald Isley in 1988 (before the Bolton/Goldmark song was written) that he had "'all his stuff'" and "'kn[e]w everything he's done.'" *Id.* at 10a. And, during the composition of the Bolton/Goldmark song, "Bolton wondered if he and Goldmark were copying a song by another famous soul singer," suggesting " 'that Bolton was contemplating the possibility that the work he and Goldmark were creating, or at least a portion of it, belonged to someone else, but that Bolton wasn't sure who it belonged to.' " *Id.* at 11a. On such evidence, the jury could reasonably infer, under the unchallenged preponderance-of-the-evidence standard, petitioners' access to the copyrighted song.

B. Substantial Similarity

Petitioners' second contention is that the decision below improperly affirms a finding of substantial similarity based on five elements of the Isley Brothers work that, if considered alone, may be unprotectible. Pet. 11-12. Petitioners do not and cannot claim any intercircuit conflict on this issue. *Id.* They contend simply that the ruling conflicts with this Court's ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). This contention is utterly baseless.

Petitioners' contention—that a combination of unprotectible elements cannot itself be protected—is directly contradicted, not supported, by *Feist*. This Court expressly held that, while "facts" are of course not subject to copyright protection, "[a] factual compilation is eligible for copyright if it features an original *selection or arrangement* of facts." 499

U.S. at 350-51 (emphasis added).[8] The decision thus recognizes that an original selection or arrangement of elements too common to be protectible themselves, whether the elements are "facts" or "ideas," is protected by copyright—necessarily so, given the fact that written works and musical compositions typically consist of selections and arrangements of unprotectible words or notes. Nothing whatever in the court of appeals' opinion on substantial similarity (Pet. App. 13a-15a) announces or even hints at a legal principle in conflict with that understanding.

The court of appeals' upholding of the jury's verdict of substantial similarity of protected expression in this case is likewise fully in accord with the *Feist* standard. The jury was instructed to afford no protection to "stock" or "commonplace" elements (Tr. 1426) and to deny liability unless it found substantial similarity under *both* an objective test (based on the experts' analyses) *and* a subjective test (based on its own listening) (Tr. 1427-28). It then specifically found not only that the Bolton/Goldmark song had ideas substantially similar to those of the Isley Brothers song but that "the expression of those ideas in Defendants' song [was] substantially similar to protected expression of those ideas in Plaintiff's song" (C.A. Supp. E.R. 64) and that, based on "all of the evidence, . . . Defendants copied protected expression in Plaintiff's song" (*id.* at 65). The court of appeals itself required satisfaction of the "two-part test of extrinsic similarity and intrinsic similarity" (Pet. App. 14a) and based its substantial-similarity ruling on the jury's determination of originality in selection (*id.* at 15a), even assuming that the pertinent "elements" would not be

---

[8] Petitioners agreed, in the court of appeals, that "[t]he district court was correct in noting that 'the compilation and arrangement of uncopyrightable elements in an original manner is protected.'" Bolton C.A. Br. 43 (emphasis on "and arrangement" deleted).

protected in isolation.[9] *Id.* (jury "'found infringement based on a *unique compilation* of those elements'" (emphasis added)). Supporting that holding was ample evidence that the selection and combination of the similar elements—including the particular arrangement of lyric, pitch sequence, and rhythm in the important title hook phrase and the verse/chorus relationship—produced original, protected expression.[10] Even the testimony of *petitioners'* expert offered significant confirmation: as the court of appeals noted, petitioners' expert "conceded that there were similarities between the two songs and that he had not found the combination of unprotectible elements in the Isley Brothers' song 'anywhere in the prior art.'" Pet. App.

---

[9] In fact, though respondent's expert initially testified that some or all of the relevant individual elements were commonplace (Tr. 608, 658-59), he later testified that, on closer analysis, some were "not as common as I had previously thought" (Tr. 828-29).

[10] *See, e.g.*, Tr. 607 (discussing similarities in "Title-Hook Phrase," including lyric, pitch series, and rhythms; "Shifted Cadence," referring to final phrase of choruses; two instrumental figures; and relation between verse and chorus); Tr. 608 ("[w]hat is unusual, and absolutely extremely unusual, is to have all of these significant elements in two separate pieces"); Tr. 657-58 ("To find all seven or eight of these individual elements, there are five main ones but remember, the title hook there's a combination of three individual elements to my way of thinking was just an impossible thing. It would not happen."); Tr. 659 ("the combination of elements makes the Isley composition a protectible expression"; "Q: It's the combination, you say? A: Yes, as with any song. Most popular music is simple by nature. It's that way because it's intended to appeal to a large segment of the population. That's the nature of popular music. Keep it simple and as a result, much of the material taken individually, like pitch sequence for example, is very frequently common; but when you put it all together, it creates an individual expression. The Isley Brothers 'Love Is A Wonderful Thing' is itself a unique expression."); Tr. 781 ("because of the combination of those elements in this manner, it becomes in itself, although short, a unique expression").

15a (quoting Tr. 1236).[11] In short, there is neither a misstatement nor a misapplication of the law of substantial similarity in this case.

C. Inverse Ratio Rule

Petitioners' third question (Pet. 12-13) relates to, though it does not directly involve, the "inverse ratio rule," which "requires a lesser showing of substantial similarity if there is a strong showing of access" (Pet. App. 17a). That rule itself, as petitioners accept, is not applicable to or at issue in this case. *Id.* Rather, even while they note some judicial questioning of the rule (*id.*), petitioners complain that the Ninth Circuit refused to extend it to adopt a new "corollary," under which, when proof of access is "weak" but nevertheless sufficient to support a finding of access, a finding of copying would require something greater than the ordinary "substantial similarity" (Pet. 12-13)—though presumably less than the "striking similarity" already recognized as making proof of access altogether unnecessary (*see* Pet. App. 14a). There is no basis for review of this contention.

Petitioners do not even suggest an intercircuit conflict. Indeed, they do not identify any judicial decision, much less a court of appeals' decision, adopting a requirement of stronger-than-substantial similarity when proof of access is sufficient though "weak." More generally, there is no reason to think that this is an issue of great and recurring importance. That is reason enough to deny review.

Moreover, the refusal to adopt the suggested principle—which is relevant only to the factual issue of copying, not to

---

[11] *See also* Tr. 1174-75 and 1212 (agreeing to similarities in title motif; musical settings; "blues gospel style," including "little figures or elements"; appearance of verse in chorus; repeat coda section varying from chorus); Tr. 1172 ("Q: "you are not suggesting that there's not room for another opinion that might differ from yours in this case, are you, sir? A: I can't do that.").

the issue of legal protectibility —makes eminent sense. The ultimate factual inquiry is "copying"; the jury here had to make such a separate finding, after finding the constituent elements of access and substantial similarity; and that finding had to be one that a reasonable finder of fact could make on the evidence. The requirements of copyright law are fully met by such standards, without the ill-advised proliferation of needlessly multiplied standards of "similarity"—"substantial," "striking," and (petitioners propose) some additional unspecified standard.

Petitioners' only argument for their proposed principle is an unelaborated invocation of symmetry based on the inverse ratio rule. But the real-world practical impact of the rule petitioners take as their premise is unproved: the jury must make a finding of copying (above and beyond its findings of access and similarity), which must be reviewed for sufficient evidence under the usual standards; and petitioners do not identify cases where the sufficiency determination changed as a result of the inverse ratio rule. In any event, and dispositively, even if the inverse ratio rule allowed some otherwise-unworthy plaintiffs to prevail, that fact could not logically justify adopting petitioners' proposal for *denying* relief to plaintiffs whose evidence *is* enough to show access and substantial similarity and copying. Indeed, any argument from symmetry is particularly feeble given that, as petitioners themselves note (Pet. 12-13), there has been criticism of the inverse ratio rule itself, as perhaps distracting courts from the task of directly assessing the sufficiency of the proof of copying.[12] The merits of such criticism cannot be addressed

---

[12] *ARC Music Corp. v. Lee*, 296 F.2d 186 (2d Cir. 1961), which petitioners cite (Pet. 12 n.7), criticizes the "inverse ratio" idea as essentially a distraction from the factual question of access and similarity as a basis for inferring copying. Petitioners also cite *Beal v. Paramount Pictures Corp.*, 20 F.3d 454 (11th Cir. 1994), as "expressly reject[ing] the rule" (Pet. 12 n.7); the Eleventh Circuit in *Beal* said that the rule "ha[d] never been applied" in that circuit and held the argument to have been

in a case, like this one, where the rule is not even applicable (let alone outcome determinative). If there is merit to the criticism of the rule, however, petitioners' invocation of symmetry to deny relief to otherwise-worthy copyright plaintiffs—where copying *can* reasonably be inferred from the evidence—would only compound the wrong, not make a right.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

JOHN P. MCNICHOLAS
MCNICHOLAS & MCNICHOLAS
10866 Wilshire Blvd.
Los Angeles, CA 90024

CHARLES M. STERN
KATTEN, MUCHIN & ZAVIS
1999 Avenue of the Stars
Los Angeles, CA 90067

RICHARD G. TARANTO
(Counsel of Record)
FARR & TARANTO
1850 M Street, NW
Washington, DC 20036
(202) 775-0184

Dated: December 20, 2000

---

waived in the case before it. 20 F.3d at 460. Petitioners do not mention that the Ninth Circuit itself once raised questions about the rule. *See Smith v. Jackson*, 84 F.3d 1213, 1218 n.5 (9th Cir. 1996) (citing earlier decision).

(3)

Supreme Court, U.S.
FILED
DEC 20 2000
OFFICE OF THE CLERK

No. 00-689

In The

Supreme Court of the United States

MICHAEL BOLTON, individually and d/b/a MR. BOLTON'S MUSIC, INC., ANDREW GOLDMARK, NONPAREIL MUSIC, INC., WARNER CHAPPELL MUSIC LIMITED, WARNER-TAMERLANE PUBLISHING CORP., WB MUSIC CORP. and SONY MUSIC ENTERTAINMENT, INC.,

Petitioners,

v.

THREE BOYS MUSIC CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF BY AMICUS CURIAE RECORDING INDUSTRY ASSOCIATION OF AMERICA, INC. IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

LOUIS P. PETRICH
Counsel of Record
DAVID ARONOFF
LEOPOLD, PETRICH & SMITH, P.C.
2049 Century Park East, Suite 3110
Los Angeles, California 90067-3274
(310) 277-3333

Attorneys for Amicus Curiae Recording Industry Association of America, Inc.

26 pp

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. INTEREST OF THE AMICUS 6

III. REASONS WHY THE PETITION SHOULD BE GRANTED 7

A. THE NINTH CIRCUIT HAS SO LOWERED THE STANDARD TO PROVE "ACCESS" AS TO THREATEN ALL FUTURE ATTEMPTS TO DISPOSE OF UNMERITORIOUS CLAIMS AS A MATTER OF LAW 9

B. THE NINTH CIRCUIT'S RELIANCE ON THE DISCREDITED *"ARNSTEIN"* DECISION THREATENS TO DE-STABILIZE PRECEDENTS ALLOWING COURTS TO RULE AS A MATTER OF LAW WHETHER COMPETING WORKS ARE SUBSTANTIALLY SIMILAR IN THEIR PROTECTIBLE EXPRESSION 14

C. THE CIRCUIT'S CREATION OF A UNIQUE AND UNPRINCIPLED "EXCEPTION" TO THE "INVERSE RATIO RULE" IS UNWARRANTED, AND FURTHER EXPOSES AUTHORS TO UNFOUNDED LITIGATION 18

IV. CONCLUSION 19

TABLE OF AUTHORITIES

Page(s)

CASES:

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986) . . 8, 10

Apple Computer, Inc. v. Microsoft Corp., 35 F. 3d 1435 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184 (1995) 15

ARC Music Corp. v. Lee, 296 F. 2d 186 (2d Cir. 1961) 19

Arnstein v. Porter, 154 F. 2d 464 (2d Cir. 1946). . . *passim*

Benson v. Coca-Cola Co., 795 F. 2d 973 (11th Cir. 1986) 8, 11

Berkic v. Crichton, 761 F. 2d 1289 (9th Cir.), *cert. denied*, 474 U.S. 826 (1985) 15, 16, 17

Bose Corp. v. Consumers Union, 466 U.S. 485 (1984) 2, 9, 17

Ellis v. Diffie, 177 F. 3d 503 (6th Cir. 1999) 12

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) 14, 15, 17, 18, 19

Ferguson v. National Broadcasting Co., 584 F. 2d 111 (5th Cir. 1978) 8, 11

First National Bank of Arizona v. Cities Service Co., 391 U.S. 253 (1968) 8

Fogerty v. Fantasy, Inc., 510 U.S. 517 (1994) 6

Goldhirsh Group, Inc. v. Alpert, 107 F. 3d 105 (2d Cir. 1997) 9

Grubb v. KMS Patriots, L.P., 88 F. 3d 1 (1st Cir. 1996) 8, 11

Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985) 3, 4, 16

Harper House, Inc. v. Thomas Nelson, Inc., 889 F. 2d 197 (9th Cir. 1989) 15, 16

TABLE OF AUTHORITIES – Continued

Page(s)

Herzog v. Castle Rock Entertainment, 193 F. 3d 1241 (11th Cir. 1999) 8, 12, 15, 17

Hoehling v. Universal City Studios, Inc., 618 F. 2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980) ..15, 17

Jason v. Fonda, 698 F. 2d 966 (9th Cir. 1982) ... 8, 9, 10, 11

Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495 (1952) 2

Kouf v. Walt Disney Pictures & Television, 16 F. 3d 1042 (9th Cir. 1994) 15, 16, 17

Litchfield v. Spielberg, 736 F. 2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985) 15, 16, 17

Malkin v. Dubinsky, 146 F. Supp. 111 (S.D.N.Y. 1956) 16

Meta-Film Assocs., Inc. v. MCA, Inc., 586 F. Supp. 1346 (C.D. Cal. 1984) 8, 12, 13

Mills Music v. Snyder, 469 U.S. 153 (1984) 6

Nash v. CBS, Inc., 899 F. 2d 1537 (7th Cir. 1990)..15, 17

New York Times Co. v. Tasini, Dkt. No. 00-201, *cert. granted* 11/6/2000 6

Newton v. National Broadcasting Co., 930 F. 2d 622, 680 (9th Cir. 1990), *cert. denied*, 502 U.S. 866 (1991) 9

Olson v. National Broadcasting Co., 855 F. 2d 1446 (9th Cir. 1988) 15, 17

Repp v. Webber, 858 F. Supp. 1292 (S.D.N.Y. 1994), *reversed on other grounds*, 132 F. 3d 882 (2d Cir. 1997), *cert. denied*, 525 U.S. 815 (1998) 8, 11

Selle v. Gibb, 741 F. 2d 896 (7th Cir. 1984) 8, 11

TABLE OF AUTHORITIES – Continued

Page(s)

Shaw v. Lindheim, 919 F. 2d 1353 (9th Cir. 1990) 19

Sid & Marty Krofft Television Prods., Inc. v. McDonalds Corp., 562 F. 2d 1157 (9th Cir. 1977) 4

Takeall v. Pepsico, Inc., 809 F. Supp. 19 (D. Md. 1992), *aff'd*, 14 F. 3d 596 (4th Cir. 1993), *cert. denied*, 512 U.S. 1236 (1994) 8, 11

Texas v. Johnson, 491 U. S. 397 (1989) 2

Towler v. Sayles, 76 F. 3d 579 (4th Cir. 1996) .. 8, 11, 15, 17

Walker v. Time-Life Films, Inc., 784 F. 2d 44 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986) 15, 17

Williams v. Crichton, 84 F. 3d 581 (2d Cir. 1996) .. 15, 17

Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) 2

RULES AND STATUTES:

Supreme Court Rule 37.6 1

TREATISES:

P. Goldstein, Copyright (2d ed. 2000) Vol. 2: § 7.2.1 12

M. & D. Nimmer, *Nimmer On Copyright* (2000)

Vol. 1:
§ 1.10 ..... 4, 15

§ 2.01 13

§ 2.01[A] 13

TABLE OF AUTHORITIES – Continued

Page(s)

Vol. 3:
§ 12.11[B][1] 13

§ 12.10[B][3] 8

Vol. 4:
§ 13.03[A][1] 15

§ 13.01[B] 8, 14, 18

§ 13.03[D] 18

§ 13.03[E][3] 17

§ 13.04[E][3] 5

E. Volokh & B. McDonnell, "Freedom of Speech and Independent Judgment Review in Copyright Cases" (1998) 107 Yale L.J. 2431 ..... *passim*

MISCELLANEOUS:

Annual Report of the Register of Copyrights (1968) 13

I. INTRODUCTION

The Recording Industry Association of America, Inc. (RIAA) ("amicus")[1] supports the petition for a writ of certiorari to review the May 9, 2000 decision (reproduced in Appendix A) of the Ninth Circuit Court of Appeals, reported at 212 F. 3d 477.[2]

This case raises important questions concerning the proper role of courts in setting benchmarks for what constitutes substantial evidence of "access" and the need for independent review of jury verdicts that find protected speech to constitute copyright infringement. The Ninth Circuit's decision conflicts with decisions of this Court and other circuits and ignores the duty of appellate courts to conduct de novo or independent review of legal and policy issues, especially where liability depends upon setting and determining the boundaries of free speech.

It is not surprising that commercially successful songs, recordings, movies, books and television series attract copyright infringement claims. The substantial remedies provided by the Copyright Act[3] – damages, disgorgement of profits, injunctive relief, destruction and attorney's fees – offer plaintiffs a powerful incentive to

---

[1] As required by Sup. Ct. R. 37.6, RIAA represents that none other than the amicus has made a monetary contribution to the preparation or submission of this brief.

[2] All parties have given their written consents to the filing of this Brief, which consents will be filed with the Court.

[3] Copyright Act of 1976, as amended, §§ 502-505, 17 U.S.C. §§ 502-505.

sue. Nor should it be surprising that the threat of protracted litigation and the risk of large jury verdicts can serve to chill investment of creative efforts and money.[4]

But songs, motion pictures, television programs and books are "speech" entitled to First Amendment protections. *See Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 578 (1977) ("there is no doubt that entertainment, as well as news, enjoys First Amendment protection"); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (books, newspapers, magazines and movies are forms of expression that do not lose their First Amendment protections because they are sold for profit); *Texas v. Johnson*, 491 U.S. 397, 406 (1989) (to be protected under Free Speech Clause, activity must be sufficiently imbued with elements of communication). In areas other than copyright, such as defamation law, where tort law liability rules put speech at risk, courts have fashioned special substantive and procedural rules: burdens of proof are shifted, substantive rules are changed to expand the risk-free sphere of speech, summary adjudication is encouraged, and verdicts are subjected to independent review on appeal. *See Bose Corp. v. Consumers Union*, 466 U.S. 485, 502-511 (1984); E. Volokh & B. McDonnell, "Freedom of Speech and Independent Judgment Review

---

[4] In this case, the jury awarded plaintiff many times more than the amounts earned by the defendant creators, Bolton and Goldmark. Petition for certiorari, at 10. In addition, because of contractual and implied indemnities, creators may be called on to defend and indemnify distributors and retailers for amounts much larger than they ever realized from creating the allegedly infringing work.

in Copyright Cases," 107 Yale L.J. 2431, 2439-41 (1998) ("Volokh" hereafter).

Although this Court has agreed that the copyright law's idea/expression dichotomy "strike[s] a definitional balance between the First Amendment and the Copyright Act",[5] courts have been slow to develop and apply special procedural and substantive rules to protect the free speech interests that conflict with copyright law.[6] The Ninth Circuit's decision threatens to undo what case law protections have developed.

Over fifty years ago, the then-leading decision, *Arnstein v. Porter*, 154 F. 2d 464, 468 (2d Cir. 1946), announced a rule openly hostile to summary judgment, or any disposition as a matter of law, requiring a trial if there was even the "slightest doubt" about the circumstantial evidence of copying, and disparaging a judge's ability or duty to decide substantial similarity issues, as a matter of law. 154 F. 2d at 468, 473.

Over the next 50 years, even as this Court reversed the early hostility to summary judgments, the circuits repudiated the "slightest doubt" rule of *Arnstein* and came to agree that meritless infringement claims could be dismissed as a matter of law where plaintiff failed to show (1) that the subject works were substantially the same in their protectible expression, or (2) that any actionable similarities arose from actual copying, based

---

[5] *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985), quoting the Second Circuit's opinion, 723 F. 2d 195, 203 (2d Cir. 1983).

[6] *See Volokh*, 107 *Yale L.J.* at 2439-41.

on circumstantial evidence that such similarities indicated copying ("probative similarity") and that the creator of defendant's work had a reasonable opportunity to read or hear plaintiff's work ("access") by reason of wide public dissemination or through intermediaries.

The Ninth Circuit's decision below threatens to undermine those salutary and nationwide rules. Although the Ninth Circuit purports to render a narrow, fact-specific decision ("we will not disturb the jury's factual and credibility determinations"), App. A, at 8, by relying on the "slightest doubt" rule of *Arnstein* in copyright litigation, and applying that abandoned rule where evidence of "access" was *de minimis*, it exposes authors' reputations and incomes to unreviewable decisions by juries allowed to speculate about evidence or the lack of it.

Indeed, the Ninth Circuit's apparent encouragement of standard-free decision-making is inexplicable in light of the well-established rule that copyright rules regulating speech pass constitutional muster only because they are intended to balance First Amendment considerations. *See, Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 555-60 (1985); *Sid & Marty Krofft Television Prods., Inc. v. McDonalds Corp.*, 562 F. 2d 1157, 1170 (9th Cir. 1977); Volokh, 107 Yale L.J. at 2439-41; 1 *Nimmer*, § 1.10, at 1-66.43 to 1-82.

The stakes in assuring the courts' role as gatekeepers in copyright cases are high. For example, music is increasingly a matter not only of art, but of commerce. Sound recordings comprise an almost $15 billion domestic industry, and the foreign sales of U.S. recorded music

amount to more than $12 billion, representing approximately sixty percent of the world's consumption of music.

The composers, authors and other creative artists whose works form the backbone for these burgeoning segments of the economy should not be made to labor under the chilling effect of meritless litigation encouraged by a lax standard of "access" that allows juries to assume the creators of new works have unlawfully and subconsciously "copied" materials, which they never heard or saw. Nor should an author be subjected to the risk of liability in a case involving non-literal similarities between works – because courts are forced to defer to a jury's drawing of the constitutional balance between the First Amendment and the Copyright Act.

The ramifications of the Ninth Circuit's decision are substantial, national in scope, and chilling to the speech interests of creative artists and their distributors. In particular, by ignoring decades of precedent,[7] the Ninth Circuit resurrects discredited copyright analyses and effectively abrogates the "gatekeeping" function of the courts in copyright cases. By deferring to the jury's unbounded speculation about "access," and seemingly reopening the door to a bygone time in which dispositions as a matter of law met with extreme disfavor, the decision will prevent district courts from ruling as a

---

[7] *See generally* 4 M. & D. Nimmer, *Nimmer On Copyright*, §§ 13.04[E][3] at 13-89 to -100 (2000) ("*Nimmer*").

matter of law that meritless claims rest on mere conjecture. Forum-shopping will be encouraged.[8] The Ninth Circuit thus directly contradicts this Court's admonition that "it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible." *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526 (1994).

II. INTEREST OF THE AMICUS

RIAA is a not-for-profit corporation, whose membership consists of sound-recording producers and phonorecord manufacturers.[9] RIAA's members create, manufacture or distribute more than 90% of the authorized sound recordings in the United States, including compact disks, cassette tapes and long-playing records. Sound recordings comprise an almost $15 billion domestic industry, and foreign sales of U.S. recorded music amount to more than $12 billion, representing approximately sixty percent of the world's consumption of music. RIAA's purposes include overseeing copyright

---

[8] Although the conflict in the circuits created by the Ninth Circuit's decision itself merits review, this Court has granted review on important copyright issues even in the absence of such conflicts. *E.g.*, *New York Times Co. v. Tasini*, Dkt. No. 00-201, *cert. granted* 11/6/2000 (where recent circuit decision threatens to disrupt settled publishing practices); *Mills Music v. Snyder*, 469 U.S. 153 (1984) (holding that publisher was entitled to share in royalties from derivative works under terms of grant from author; petitioner alleged no conflict in the circuits).

[9] The RIAA has over 300 members, including such companies as EMI Recorded Music North America, BMG Entertainment North America, Universal Music Group, Warner Music Group and Sony Music Entertainment Inc. (a petitioner in this proceeding).

infringement litigation for member companies, combating all forms of music piracy throughout the United States, and ensuring that copyright legislation maintains the appropriate balance for fostering creativity in music through increased investment, production and distribution.

III. REASONS WHY THE PETITION SHOULD BE GRANTED

Over fifty years ago, the case law authority for prompt dismissal of meritless copyright claims was at its nadir. In *Arnstein v. Porter*, 154 F. 2d 464, 468 (2d Cir. 1946), the Second Circuit announced a rule openly hostile to the new summary judgment procedures of the recently enacted Federal Rules of Civil Procedure. It reversed a summary judgment in favor of the famous composer, Cole Porter, that had held that plaintiff failed to show either that the works were substantially the same or that any similarities arose from copying by defendant. The Second Circuit concluded there must be a trial, and deference to a jury verdict, if there were even the "slightest doubt" about the circumstantial evidence of copying, based on plaintiff's fanciful theory that Porter "could have" obtained access to plaintiff's song by having "stooges" burglarize plaintiff's apartment. The *Arnstein* court also disparaged a judge's ability or duty to decide substantial similarity issues, stating that perhaps if competing works were "When Irish Eyes Are Smiling" and Ravel's "Bolero", then a court could dismiss as a matter of law. 154 F. 2d at 468, 473.

Over the next 50 years, the Second and other circuits, led by decisions of this Court[10] undermined, discredited and abandoned the "slightest doubt" rule of *Arnstein*. The circuits came to agree that meritless claims could be dismissed where a plaintiff failed to show (1) that the works were substantially the same in their protectible expression,[11] or (2) that any actionable similarities arose from actual copying, based on evidence that such similarities indicated copying ("probative similarity")[12] and that the creator of defendant's work had a reasonable opportunity to read or hear plaintiff's work ("access") by reason of wide public dissemination[13] or through intermediaries.[14]

---

[10] *E.g., Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986) (courts are to consider the constitutionally mandated "clear and convincing" standard of proof regarding alleged defamation of public figures); *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253 (1968); *see Ferguson v. National Broadcasting Co.*, 584 F. 2d 111, 114 (5th Cir. 1978).

[11] 3 *Nimmer*, § 12.10[B][3], at 12-151 to -156; 4 *Nimmer*, § 13.01[B] at 13.8 to -14.

[12] 4 *Nimmer*, § 13.01[B], at 13.10 to -13.

[13] *See, e.g., Ferguson v. National Broadcasting Co.*, 584 F. 2d 111, 112-13 (5th Cir. 1978); *Selle v. Gibb*, 741 F. 2d 896, 901 (7th Cir. 1984); *Takeall v. Pepsico, Inc.*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, 14 F. 3d 596 (4th Cir. 1993), *cert. denied*, 512 U.S. 1236 (1994); *Benson v. Coca-Cola Co.*, 795 F. 2d 973, 975 (11th Cir. 1986); *Repp v. Webber*, 858 F. Supp. 1292, 1301-03 (S.D.N.Y. 1994), *reversed on other grounds*, 132 F. 3d 882 (2d Cir. 1997), *cert. denied*, 525 U.S. 815 (1998).

[14] *See, e.g., Grubb v. KMS Patriots, L.P.*, 88 F. 3d 1, 3-5 (1st Cir. 1996); *Towler v. Sayles*, 76 F. 3d 579, 582-83 (4th Cir. 1996); *Jason v. Fonda*, 698 F. 2d 966, 967 (9th Cir. 1982); *Meta-Film Assocs., Inc. v. MCA, Inc.*, 586 F. Supp. 1346, 1355-59 (C.D. Cal. 1984); *Herzog v. Castle Rock Entertainment*, 193 F. 3d 1241 (11th Cir. 1999).

The Ninth Circuit's decision below threatens to undermine those salutary and nationwide rules. By resurrecting the "slightest doubt" rule of *Arnstein* in copyright litigation, the Ninth Circuit's decision exposes authors' reputations and incomes to unreviewable decisions by juries based on speculation and conjecture.

A. THE NINTH CIRCUIT HAS SO LOWERED THE STANDARD TO PROVE "ACCESS" AS TO THREATEN ALL FUTURE ATTEMPTS TO DISPOSE OF UNMERITORIOUS CLAIMS AS A MATTER OF LAW

The Ninth Circuit purports simply to affirm a jury's resolution of credibility issues, and thus "not [to] establish[ ] a new standard for access in copyright cases." App. A, at 8. However, the issue before the Ninth Circuit was not about disputed evidence or credibility,[15] but whether the acknowledged "evidence" was substantial enough to support a finding of "access" *or* whether the proffered evidence of access constituted only impermissible speculation and conjecture. *See Jason v. Fonda*, 698 F. 2d 966, 967 (9th Cir. 1982) (a "bare possibility" is not sufficient evidence). The Ninth Circuit's conclusion that "access" was "entirely plausible" from the evidence in the record (App. A, at 5061), creates a radically new and lax "access" standard that is completely at odds with that circuit's no-

---

[15] A trier's disbelief of a defendant's denial of access does not constitute affirmative substantial evidence of access. *See Bose Corp. v. Consumers Union*, 466 U.S. 485, 512 (1984); *Goldhirsh Group, Inc. v. Alpert*, 107 F. 3d 105, 109 (2d Cir. 1997); *Newton v. National Broadcasting Co.*, 930 F. 2d 622, 680 (9th Cir. 1990), *cert. denied*, 502 U.S. 866 (1991).

circuit's no-bare-possibility standard in *Jason* and all other circuits which have opined on "access" since *Arnstein*. The Ninth Circuit exaggerated this misstep by relying on the long-discredited "slightest doubt" rule of *Arnstein*, 154 F. 2d at 468. *See* Petition, at 11. If the Ninth Circuit's decision[16] stands, district courts will consider themselves effectively disabled from ruling as a matter of law that *any* evidence offered as proof of access is mere conjecture, and insufficient.

The issue on appeal – the sufficiency of the evidence presented by plaintiff as a matter of law to support the "access" finding of the jury – did not present a factual or "credibility" issue but rather a legal issue, which may be disposed of under the same standard applicable to a motion for summary judgment. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986). Ultimately, the question of whether the evidence in this case was sufficient presented a policy issue for judges, suitable for determination as a matter of law. Thus, the Ninth Circuit's decision will almost certainly be trumpeted as the standard for what access evidence is sufficient to create a triable issue in the context of motions for summary judgment and

---

[16] The Ninth Circuit further confounded the "access" analysis by relying on decisions about "subconscious copying," *in which the defendants' "access" to the plaintiff's work had first been admitted or decided* and the only remaining issue was whether the defendants could be held culpable for *unintentionally* copying the plaintiffs' works. App. A, at 5-8. By purporting to determine the existence of "access" by reference to the unrelated theory of "subconscious copying," the Ninth Circuit effectively "decided" that substantial evidence of access existed by *assuming* its existence.

judgment as a matter of law, and on appeals from bench trials as well as jury verdicts. For, although it is difficult to create a bright line test on this issue, courts must create benchmarks on a case by case basis that guide authors, their attorneys, and potential plaintiffs. *See* Volokh, 107 Yale L.J. at 2455-59. The Ninth Circuit's decision threatens to undermine all the benchmarks created these past fifty years.

As a result, the Ninth Circuit's lowered threshold for access directly conflicts with its own authority in *Jason*,[17] and with the law of other circuits concerning access allegedly attained through public dissemination. *See, e.g., Ferguson v. National Broadcasting Co.*, 584 F. 2d 111, 112-13 (5th Cir. 1978); *Selle v. Gibb*, 741 F. 2d 896, 901 (7th Cir. 1984); *Takeall v. Pepsico*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, 14 F. 3d 596 (4th Cir. 1993); *Benson v. Coca-Cola Co.*, 795 F. 2d 973, 975 (11th Cir. 1986); *Repp v. Webber*, 858 F. Supp. 1292, 1301-03 (S.D.N.Y. 1994), *reversed on other grounds*, 132 F. 3d 882 (2d Cir. 1997).[18]

---

[17] Because the Ninth Circuit creates a rule of total deference to a jury determination of "access", it does not attempt to distinguish *Jason* (App. A, at 5) which was decided on a motion for summary judgment. It fails to acknowledge that *Jason* created a benchmark that "access" evidence as speculative as that presented to the jury in this case was not substantial evidence.

[18] By a parity of reasoning, the Ninth Circuit's highly deferential standard will no doubt be argued to apply to claims of access through intermediaries, putting the Ninth Circuit in direct conflict with decisions granting summary judgment, or judgment as a matter of law, for defendants under that fact pattern. *See, e.g., Grubb v. KMS Patriots, L.P.*, 88 F. 3d 1, 3-5 (1st Cir. 1996); *Towler v. Sayles*, 76 F. 3d 579, 582-83 (4th Cir. 1996);

Inferential proof of copying-in-fact through evidence of access and probative similarity is a "question of probabilities." 2 P. Goldstein, *Copyright*, § 7.2.1, at 7:6 (2d ed. 2000). The "probability" of copying may be high where the evidence of access is strong. However, if composers, writers and other creative artists may be deemed to have "access" to works that received minimal public dissemination decades earlier, in geographically remote areas, it is certain that "copying" will be inferred in many cases where defendants never heard or saw plaintiff's work. When lax standards are allowed to prove "access", they improperly punish creative artists by allowing juries – without clear standards – to infer copying based on extraneous factors or hunches.

Under these standards, or the lack of them, composers, writers and other creative artists will be put to a tremendous disadvantage in defending an ever-increasing number of infringement actions brought by the owners of barely disseminated works.[19]

Meta-Film Assocs., Inc. v. MCA, Inc., 586 F. Supp. 1346, 1355-59 (C.D. Cal. 1984); *Herzog v. Castle Rock Entertainment*, 193 F. 3d 1241 (11th Cir. 1999). And, *see Ellis v. Diffie*, 177 F. 3d 503 (6th Cir. 1999) (no "clear error" in rejecting speculative evidence of access through intermediary record executive).

[19] As a practical matter, the Ninth Circuit's lowered standard will charge creators of new works with notice of huge numbers of prior works with extremely limited dissemination. In effect, the Ninth Circuit approved a jury verdict consistent with the conclusion that the petitioner-composers probably heard and recalled *all* barely disseminated music for at least the past 25 years. During the Copyright Office's fiscal year ended June 30, 1967 *alone* (which includes the period during which respondent's song was supposedly "disseminated"), copyrights

Instead of a level playing field, defendants in such cases will find that because of limited public dissemination of plaintiff's work, to which they were never exposed, they can be inferentially held to have "copied." And, because a defendant's creative work frequently is composed in private, defendants will not easily be able to refute the unfounded inference with proof of independent creation. In practice, the mere fact that a defendant's work is somewhat similar to an earlier, obscure work will become the standard for liability. Creators will be pressed to prove "novelty" to avoid liability.

The Ninth Circuit's lowering of the bar for proof of "access" will also have another unintended consequence. The same loosened "access" standard that facilitates proof of infringement may also be used by defendants to create an inference that material in a *plaintiff's* copyrighted work was copied from a prior work and thus is not "original" and entitled to protection. 1 *Nimmer*, § 2.01; 3 *Nimmer*, § 12.11[B][1] at 12-164 & n. 48. As a practical matter, copyright owners may be required to prove that their works are "novel," unlike any prior work. *See* 1 *Nimmer*, § 2.01[A] at 2-8 to -9 ("such a course of action would constitute the most radical upheaval in all of copyright doctrine"). Thus, creators will be subjected to attack from both directions.

---

in 79,291 musical compositions were registered in the U.S. *Annual Report of the Register of Copyrights* at 26 (1968). It would be just as illogical to assume that every member of the Ninth Circuit was familiar with the "expression" of every appellate brief filed in that or in any other circuit court during the past 25 years. *Cf. Meta-Film*, 586 F. Supp. at 1355-56.

B. THE NINTH CIRCUIT'S RELIANCE ON THE DISCREDITED *"ARNSTEIN"* DECISION THREATENS TO DE-STABILIZE PRECEDENTS ALLOWING COURTS TO RULE AS A MATTER OF LAW WHETHER COMPETING WORKS ARE SUBSTANTIALLY SIMILAR IN THEIR PROTECTIBLE EXPRESSION

Liability for infringement requires proof that original, protected expression owned by a plaintiff has been copied from plaintiff's work by defendant. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 361 (1991). It is now well-established that "copying" involves two distinct elements: a showing (1) that defendant's work is substantially similar to protected expression in plaintiff's work ("substantial similarity"); and (2) that such substantial similarities were in fact derived from plaintiff's work (copying-in-fact), and not by copying from other sources (*e.g.*, public domain or licensed works) or independent creation. *Feist*, 499 U.S. at 361 ("Not all copying . . . is copyright infringement"); 4 *Nimmer*, § 13.01[B] at 13-8 to -14; *see also*, Volokh, 107 Yale L.J. at 2439 & n. 55.

The 1946 *Arnstein* decision was hostile to the idea that a court could determine as a matter of law the issue of whether two works were substantially similar in their protected expression. *Arnstein*, 146 F. 2d at 473 (stating the issue to be entirely *factual*, and allowing that summary judgment might be proper if the competing works were "When Irish Eyes Are Smiling" and Ravel's "Bolero"). Decades of subsequent precedent have shown the basic assumption of *Arnstein* to be flawed.

The "substantial similarity of expression" issue is often a *legal* issue, or at least a mixed issue of fact or law, susceptible of resolution as a matter of law. Volokh, 107 Yale L.J. at 2439-40 & n. 57. This is because one component of the issue – protectibility – is often purely legal: plaintiff's monopoly does not include ideas, facts, scenes à faire or the commonplace.[20] *See Feist*, 499 U.S. at 361; *Williams v. Crichton*, 84 F. 3d 581, 587 (2d Cir. 1996); *Walker v. Time-Life Films, Inc.*, 784 F. 2d 44, 48 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986); *Hoehling v. Universal City Studios, Inc.*, 618 F. 2d 972, 977-80 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980) (distinguishing *Arnstein*), *cert. denied*, 449 U.S. 841 (1980); *Towler*, 76 F. 3d at 583-84 (4th Cir. 1996); *Kouf v. Walt Disney Pictures & Television*, 16 F. 3d 1042, 1044-46 (9th Cir. 1994); *Berkic v. Crichton*, 761 F. 2d 1289, 1293-94 (9th Cir.), *cert. denied*, 474 U.S. 826 (1985); *Litchfield v. Spielberg*, 736 F. 2d 1352, 1356-57 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985); *Olson v. National Broadcasting Co.*, 855 F. 2d 1446, 1451-53 (9th Cir. 1988) (JNOV); *Nash v. CBS, Inc.*, 899 F. 2d 1537, 1539, 1543 (7th Cir. 1990); *Herzog*, 193 F. 3d 1241 (11th Cir. 1999). Moreover, when the alleged similarities are non-literal, a policy issue exists about the extent to which a court will expand plaintiff's monopoly beyond the literal to prohibit defendant's non-literal resemblance, *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F. 2d 197, 201 (9th Cir. 1989); 1 *Nimmer*, § 1.10[B][2] at 1-75 to -76; 4 *Nimmer*,

---

[20] The first step in analyzing "substantial similarity" is to determine the scope of protection for plaintiff's and defendant's works. *Feist*, 499 U.S. at 361-62; *Apple Computer, Inc. v. Microsoft Corp.*, 35 F. 3d 1435, 1442-43 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184 (1995).

§ 13.03[A][1] at 13-29 to -36[21] – an issue this Court has yet to decide. *Harper & Row*, 471 U.S. at 547.

This Court has agreed that the copyright law's idea/expression dichotomy has a constitutional dimension and "strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression." *Harper*, 471 U.S. at 556. "*Harper & Row* thus suggests that the line between using others' expression and using their ideas is of First Amendment significance." Volokh, 107 Yale L.J. at 2434.

This Court noted the constitutional infirmity of deferring to triers of fact on issues fraught with constitutional significance, in the trade disparagement context:

> Providing triers of fact with a general description of the type of communication whose content is unworthy of protection has not, in and of itself, served sufficiently to narrow the category,

---

[21] This policy issue is highlighted because the Ninth Circuit's decision holds that a "combination of unprotectible elements" in a "unique compilation" supports a finding of substantial similarity of protected expression. App. A, at 10. The Ninth Circuit supported its reasoning by citing *Malkin v. Dubinsky*, 146 F. Supp. 111 (S.D.N.Y. 1956), a New York decision that was then required to follow *Arnstein*. App. A, at 9. The circuit did not consider more recent, conflicting decisions in the circuit holding that such "compilation works" are entitled to only "extremely limited copyright protection" (*Harper House*, 889 F. 2d at 205) and that "compilations" of random similarities are not actionable. *Kouf*, 16 F. 3d at 1045-46; *Berkic*, 761 F. 2d at 1293-94; *Litchfield v. Spielberg*, 736 F. 2d 1352, 1356 (9th Cir. 1984). Not only musical works but also biographies, histories and other fact-based works are put at risk by the circuit's decision.

> nor served to eliminate the danger that decisions by triers of fact may inhibit the expression of protected ideas.

Bose, 466 U.S. at 505. For that reason, the *Bose* Court held that courts must independently review judgments that an allegedly disparaging statement is unprotected. 466 U.S. at 511. Since a factfinder in a copyright case may misclassify the defendant's speech as unprotected, or may erroneously conclude that it used another's expression, independent review, not deference, is required. Volokh, 107 Yale L.J. at 2437.

Similarly, since *Arnstein*, the decisions are legion that hold "substantial similarity of protected expression" may be decided as a matter of law. *See Feist*, 499 U.S. at 361; *Williams v. Crichton*, 84 F. 3d 581, 587 (2d Cir. 1996); *Walker v. Time-Life Films, Inc.*, 784 F. 2d 44, 48 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986); *Hoehling v. Universal City Studios, Inc.*, 618 F. 2d 972, 977-80 (2d Cir. 1980) (distinguishing *Arnstein*); *Towler*, 76 F. 3d at 583-84 (4th Cir. 1996); *Kouf*, 16 F. 3d at 1044-46 (9th Cir. 1994); *Berkic v. Crichton*, 761 F. 2d 1289, 1293-94 (9th Cir. 1985); *Litchfield v. Spielberg*, 736 F. 2d 1352, 1356-57 (9th Cir. 1984); *Olson v. National Broadcasting Co.*, 855 F. 2d 1446, 1451-53 (9th Cir. 1988) (JNOV); *Nash v. CBS, Inc.*, 899 F. 2d 1537, 1539, 1543 (7th Cir. 1990); *Herzog*, 193 F. 3d 1241 (11th Cir. 1999); *see also* 4 *Nimmer*, § 13.03[E][3] at 13-89 to -100 (collecting cases).

By resurrecting *Arnstein*, the Ninth Circuit's decision poses a substantial threat to undermine the "gatekeeping" function of the courts which is recognized in these decisions.

C. THE CIRCUIT'S CREATION OF A UNIQUE AND UNPRINCIPLED "EXCEPTION" TO THE "INVERSE RATIO RULE" IS UNWARRANTED, AND FURTHER EXPOSES AUTHORS TO UNFOUNDED LITIGATION

The Ninth Circuit's decision (App. A, at 10-11), unjustifiably creates a new exception to the "Inverse Ratio Rule" as support for the jury's decision on the "substantial similarity" or improper appropriation issue.[22] In doing so, the circuit illogically, and without any supporting authorities, *sua sponte* converts the "Rule" for the first time into a "one-way street" that deliberately operates only to reduce a plaintiff's burden of proof. This reliance on the Rule and the circuit's newly-minted exception is unwarranted.

The proper context for application of the "Inverse Ratio Rule" is controversial and much debated. *See* 4 *Nimmer*, § 13.03[D] at 13-76 to -78 & n. 198.1. Its proper domain – to weigh the relative probative similarities and access evidence needed to support an inference of *actual copying* – is not presented by this case. What is presented by the Ninth Circuit's decision is the improper expansion of the Rule from the issue of actual copying to that of

---

[22] A latent ambiguity has always existed in the Ninth Circuit's statement of the Rule – "a lesser showing of substantial similarity [is required to prove *copying*] if there is a stronger showing of access". App. A, at 10-11. The circuit has rarely been clear whether it uses "copying" to mean actual copying or substantial similarity as to protected expression, or both. Because "Not all copying . . . is copyright infringement", that distinction is critical. *Feist*, 499 U.S. at 361; 4 *Nimmer*, § 13.01[B] at 13-8 to -14; Volokh, 107 Yale L.J. at 2439 n. 55.

substantial similarity of protected expression. See Shaw v. Lindheim, 919 F. 2d 1353, 1362 (9th Cir. 1990). The Ninth Circuit is alone in making this application of the Rule. *See ARC Music Corp. v. Lee*, 296 F. 2d 186, 187-88 (2d Cir. 1961) (rejecting Inverse Ratio Rule in this context). By holding that this Rule even applies to the substantial similarity issue, the Ninth Circuit has further undermined proper independent review of an issue of constitutional dimensions.

Perhaps recognizing the illogic of its application of the Rule in this context, the Ninth Circuit's decision does not attempt to explain *why* less access does not increase the amount of resemblance needed to constitute "substantial similarity of protected expression." Would more access create a broader scope of protected expression? *But see Feist*, 499 U.S. at 361. Would greater access create liability for similarity of *un*protected material? *See id.* The Ninth Circuit reasoned itself into this corner with its earlier decisions; when faced with the reality of its logic, it blinked. The Rule cannot be so applied consistent with this Court's decision in *Feist*.

IV. CONCLUSION

The Ninth Circuit's decision threatens to subject creative efforts, speech interests, and substantial investments to a judicial deference for jury verdicts that improperly sanctions unpredictable legal results, with attendant deleterious consequences both to free speech and the copyright laws. Too much speech will be wrongly punished and too many reputations will be sullied while

the Ninth Circuit's decision percolates through the federal courts, even if the Ninth Circuit ultimately tries to "right" itself. The Petition for a writ of certiorari should be granted.

DATED: December 20, 2000

Respectfully submitted,

LEOPOLD, PETRICH & SMITH, P.C.
LOUIS P. PETRICH
Counsel of Record
DAVID ARONOFF
Attorneys for Amicus Curiae
The Recording Industry
Association of America, Inc.

(4)

No. 00-689

Supreme Court, U.S.
FILED
JAN 2 - 2001

IN THE

Supreme Court of the United States

MICHAEL BOLTON, individually and d/b/a MR. BOLTON'S MUSIC, INC., ANDREW GOLDMARK, NONPAREIL MUSIC, INC., WARNER CHAPPELL MUSIC LIMITED, WARNER TAMERLANE PUBLISHING CORP., WB MUSIC CORP., and SONY MUSIC ENTERTAINMENT, INC.,

Petitioners,

v.

THREE BOYS MUSIC CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

REPLY BRIEF

ROBERT G. SUGARMAN
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
(212) 310-8184

ALAN M. DERSHOWITZ
Counsel of Record
1525 Massachusetts Avenue
Cambridge, MA 02138
(617) 495-4617

RUSSELL J. FRACKMAN
MITCHELL SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064
(310) 312-2000

Attorneys for Petitioners

164446

Counsel Press LLC
(800) 274-3321 • (800) 359-6859

15 pp

TABLE OF CONTENTS

	Page
Table of Cited Authorities	ii
Argument	1
1. The Ninth Circuit Established a New Access Standard and Abrogated the Courts' Crucial Gate-keeping Function in Copyright Cases.	1
2. The Ninth Circuit Also Implemented And Imposed A New Standard For Protectibility Inconsistent With This Court's Ruling in Feist.	7
3. The Inverse Ratio Rule Presents An Issue Of Significant Importance And Was Determinative In This Case.	8
Conclusion	10

TABLE OF CITED AUTHORITIES

Page

Cases:

ABKCO Music, Inc. v. Harrisongs Music Ltd., 722 F.2d 988 (2d Cir. 1983) 6

Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946) ... 1, 2, 3, 6

Benson v. Coca-Cola Co., 795 F.2d 973 (11th Cir. 1986) 4

Bose Corp. v. Consumers Union of U.S., Inc., 466 U.S. 485 (1984) 2, 3, 4, 6

Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994) 3

Feist Publications, Inc. v. Rural Telephone Serv. Co., 499 U.S. 340 (1991) 7

Grubb v. KMS Patriots, L.P., 88 F.3d 1 (1st Cir. 1996) 2

Harper & Row v. Nation Enterprises, 471 U.S. 539 (1985) 8

Hurley v. Irish-American Gay, Lesbian, and Bisexual Group, 515 U.S. 557 (1995) 3

Intersong-USA v. CBS, Inc., 757 F. Supp. 274 (S.D.N.Y. 1991) 5

Cited Authorities

	Page
Jason v. Fonda, 526 F. Supp. 774 (C.D. Cal. 1981), *affd*, 698 F.2d 966 (9th Cir. 1982)	4
Jenkins v. Georgia, 418 U.S. 153 (1974)	6
Jewel Music Publishing Co. v. Leo Feist, Inc., 62 F. Supp. 596 (S.D.N.Y. 1945)	5
McRae v. Smith, 968 F. Supp. 559 (D. Colo. 1997)	5
Morse v. Fields, 127 F. Supp. 63 (S.D.N.Y. 1954)	2
New York Times Co. v. U.S., 403 U.S. 713 (1971)	8
Novak v. National Broadcasting Co., 752 F. Supp. 164 (S.D.N.Y. 1990)	5
Renton v. Playtime Theatres, Inc., 475 U.S. 41 (1986)	4
Takeall v. Pepsico, Inc., 809 F. Supp. 19 (D. Md. 1992), *aff'd*, No. 93-1237, 14 F.3d 596, 1993 WL 509876 (4th Cir. Dec. 8, 1993), *cert. denied*, 512 U.S. 1236 (1994)	4
Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977)	8

Cited Authorities

Page

United States Constitution:

First Amendment ..... *passim*

Other Authorities:

II P. Goldsten, Copyright § 7.2.1 (2nd ed. 2000) .. 8

E. Volokh & B. McDonnell, "Freedom of Speech and Independent Judgment Review in Copyright Cases," 107 Yale L.J. 2431 (1998) 3, 7

M.B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?* 17 UCLA L. Rev. 1180 (1970) 8

4 M. & D. Nimmer *On Copyright* § 13.01[B] (2000) 9

Respondent's Brief in Opposition ("Resp. Brief") avoids the key issue presented to this Court: the Constitutional implications of the Ninth Circuit's opinion in chilling speech by upsetting the balance between copyright protected expression and First Amendment freeoms.

ARGUMENT

1. The Ninth Circuit Established a New Access Standard and Abrogated the Courts' Crucial Gate-keeping Function in Copyright Cases.

Contrary to Respondent's argument, the Ninth Circuit clearly did adopt and follow *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) ("Arnstein"), and did set a new and improper standard for access, thereby abrogating the courts' necessary and traditional gate-keeping role in area of free speech. The standard imposed by the Ninth Circuit is the outdated, discredited *Arnstein* standard of virtually complete deference to juries — a standard rejected in other Circuits and contrary to this Court's opinions in both the summary judgment and free speech areas. That much is clear from the portion of *Arnstein* the Ninth Circuit quoted specifically on the issue of access:

> [I]n *Arnstein v. Porter*: "The judge characterized plaintiff's story as 'fantastic'; and in the light of the references in his opinion to defendant's deposition, the judge obviously accepted the defendant's denial of access and copying. . . . [Y]et plaintiff's credibility, even as to those improbabilities, should be left to the jury."

212 F.3d at 484, quoting *Arnstein*, 154 F.2d at 469. The Ninth Circuit standard relegates the courts to the role of complete "judicial deference" (212 F.3d at 482). It permits a jury to find access (and requires courts to sustain that finding) despite a plaintiff's "fantastic" or "improbable" theory

(as was Mr. Arnstein's theory that Cole Porter's "stooges" had broken into his house to steal his songs), relying only on so-called credibility determinations.[1]

Arnstein is predicated on the "slightest doubt" standard:

> The principal question on this appeal is whether the lower court, under Rule 56, properly deprived plaintiff of a trial of his copyright infringement action. The answer depends on whether "there is the slightest doubt as to the facts." 154 F.2d at 468 (citations omitted)

Although the Ninth Circuit did not use the words "slightest doubt," its explicit reliance on the facts and law of what it denominated the "seminal case" — *Arnstein* — re-adopts into the copyright law the discredited "slightest doubt" standard, just as surely as if those words had been used. (And, no doubt, future plaintiffs and courts, if permitted to rely on the Ninth Circuit opinion, will use those very words in describing the standard adopted below.)[2]

Significantly, in cases like these, this Court has recognized that the law is not developed by reference to generalized and vague bright lines, such as the "bare possibility" of access compared to the "reasonable opportunity" of access (to which, to be sure, the Ninth Circuit

1. It is now clear, contrary to *Arnstein*, that the denial of copying does not raise a credibility issue. *See* Brief of Amicus Curiae Recording Industry Association of America, Inc. ("RIAA Amicus Brief"), at 9 n.15; *Grubb v. KMS Patriots, L.P.*, 88 F.3d 1, 4 (1st Cir. 1996). *See also Bose Corp v. Consumers Union of U.S., Inc.*, 466 U.S. 485 (1984).

2. The Ninth Circuit expressly approved proof of infringement that it termed "highly circumstantial." The only previous copyright case to use the term "highly circumstantial" dismissed the claim of infringement precisely because the plaintiff's evidence was "highly circumstantial." *Morse v. Fields*, 127 F. Supp. 63, 69 (S.D.N.Y. 1954).

paid brief lip service); rather, the applicable standards emerge from decisions, such as *Arnstein* and the Ninth Circuit's opinion, and specifically from the facts that are deemed sufficient to satisfy those policy standards. As this Court stated in the First Amendment context of a trade disparagement case:

> [T]he content of the rule [requiring actual malice] is not revealed simply by its literal text, but rather is given meaning through the evolutionary process of common-law adjudication; though the source of the rule is found in the Constitution, it is nevertheless largely a judge-made rule of law.
>
> . . . .
>
> Providing triers of fact with a general description of the type of communication whose content is unworthy of protection has not, in and of itself, served sufficiently to narrow the category, nor served to eliminate the danger that decisions by triers of fact may inhibit the expression of protected ideas.

Bose Corp. v. Consumers Union of U.S., Inc., 466 U.S. 485, 502, 505 (1984).[3] *See also Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 596 (1994) (Kennedy, J., concurring) (fair use standard); *Hurley v. Irish-American Gay, Lesbian, and Bisexual Group*, 515 U.S. 557, 567 (1995) ("[T]he reaches of the First Amendment are ultimately defined by the facts it is held to embrace. . . .").

---

3. Put another way, cases "provide benchmarks against which future courts can compare and contrast new fact patterns." *See* E. Volokh & B. McDonnell, "Freedom of Speech and Independent Judgment Review in Copyright Cases," 107 Yale L.J. 2431, 2432 (1998). These decisions also provide guidelines for future creators and publishers. *Id.* at 2440.

The Court in *Bose* held that precisely because of the First Amendment implications, it is necessary that the courts preserve and implement their gate-keeping function by applying the rule of independent appellate review to the question of actual malice. 466 U.S. at 514. *See also id.* at 505 (special responsibility on judges whenever it is claimed that a particular communication is unprotected by the First Amendment). Here, although such a rule of review would be salutary,[4] it is not necessary to reach that issue to provide the necessary clarification of the court's function in balancing copyright and First Amendment doctrines.[5] What the Ninth Circuit has done is to erode, if not completely obliterate, the traditional gate-keeping function mandated in First Amendment cases by requiring acceptance of "fantastic" and "improbable" access theories. Respondent does not cite a single case, and there is none, that has held the type of alleged access here to be sufficient. *See, e.g., Jason v. Fonda*, 526 F. Supp. 774, 776-77 (C.D. Cal. 1981), *aff'd*, 698 F.2d 966 (9th Cir. 1982) (no access where sale of 200-700 copies in area where defendant was located); *Takeall v. Pepsico, Inc.*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, No. 93-1237, 14 F.3d 596, 1993 WL 509876 (4th Cir. Dec. 8, 1993), *cert. denied*, 512 U.S. 1236 (1994) (plaintiff's appearance on 26 radio stations over 14 years, including performances on two New York City area stations while defendants lived there, was insufficient);[6] *Benson v. Coca-Cola Co.*, 795 F.2d 973, 975 (11th Cir. 1986) (no access where plaintiff had no evidence that defendant songwriters visited any place where

4. *See generally id.*

5. *See Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 54 n.3 (1986) (holding that the Court need not reach the issue of whether "appellate courts have a duty to review de novo all mixed findings of law and fact relevant to the application of First Amendment principles").

6. The district court opinion relied on the record and noted that there were numerous performances since 1964. The unpublished Fourth Circuit opinion described the record in greater detail, noting the plaintiff's performances on 26 radio stations in 14 years.

plaintiff's song was performed during the relevant time period); *McRae v. Smith*, 968 F. Supp. 559, 563 (D. Colo. 1997) (same). *Intersong-USA v. CBS, Inc.*, 757 F. Supp. 274, 281-82 (S.D.N.Y. 1991) (radio broadcasts of plaintiff's song in New York, where on one radio station it was one of ten most-played songs, and in Miami, even while the composers of the allegedly infringing song were in those cities, was insufficient); *Novak v. National Broadcasting Co.*, 752 F. Supp. 164, 170 (S.D.N.Y. 1990) (broadcast of plaintiff's skits several times on national television show held insufficient); *Jewel Music Publishing Co. v. Leo Feist, Inc.*, 62 F. Supp. 596, 598 (S.D.N.Y. 1945) (distribution of nearly 10,000 copies of sheet music and nationwide broadcasts on CBS and NBC "on a number of occasions" was insufficient).[7]

7. Although the Ninth Circuit recognized the rule that access is proven inferentially by a direct submission or wide dissemination, the "evidence" relied upon was of neither type. Plaintiff never claimed a direct submission. The only "evidence" of "wide dissemination" of the Isley song in Connecticut, where the teen-aged writers Bolton and Goldmark lived, was the testimony of one Philadelphia disc jockey who played it five or six times on his Philadelphia show which he "imagined" (without any support) was also broadcast in Connecticut. Instead, the sum total of such evidence was such *non-sequiturs* as: Bolton's brother had a record collection; Bolton had from time to time "covered" other African-American singers (always with consent and license); reference by Bolton to another (very popular) song by another well-known writer; an off-hand introductory remark (at a benefit), where the plaintiff's witnesses themselves changed their story; broadcast of the Isley song on one other television show and three radio stations outside of Connecticut; and a near appearance on one record chart for *one week*, which was consistent only with such extremely limited broadcast. Respondent's Brief (albeit inadvertently) reflects the lack of access evidence by using the same sleight of hand used at the trial — emphasizing that the Isleys were a "hot group" (Resp. Brief at 10), and that "the Isley Brothers . . . *works* are likely to be sought out by a substantial number of fans. . . ." (*Id.* n.7) (emphasis added).

(Cont'd)

By holding access sufficient, the Ninth Circuit has, indeed, changed the standard "through the evolutionary process of common-law adjudication."[8] By tying its decision to *Arnstein*, the Ninth Circuit has insured that this sea change will be echoed in future decisions.

This Court has recognized that any impingement on First Amendment speech must be monitored carefully by the courts:

> [T]he constitutional values protected by the rule make it imperative that judges — and in some cases judges of this Court — make sure that it is correctly applied.

Bose, 466 U.S. at 502. *See also Jenkins v. Georgia*, 418 U.S. 153, 159-161 (1974) (film could not as a matter of constitutional law be found obscene, despite finding of properly instructed jury).

In the area of copyright, this judicial gate-keeping must insure that the restriction on speech imposed by the copyright law is balanced by the requirement that a plaintiff prove copying, not just similarity. Generally, such proof is attempted, as was attempted here, through access and substantial similarity. Significant lowering of those standards upsets the balance between copyright law and First

---

(Cont'd)
However, the only issue, of course, was access to this specific, single song for which there was no evidence of record sales and precious little evidence of air play.

8. Ironically, in doing so, the Ninth Circuit itself illustrated that on issues such as access the standards are set by the ***facts*** of cases. Thus, the Court at 212 F.3d at 483 reviewed and relied on the facts supporting access in *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988 (2d Cir. 1983). The Court, however, does not explain that comparison with *Harrisongs* (where plaintiff's popular song was a number one hit in the U.S. and a hit in England) starkly illustrates the ***lack*** of such evidence here.

Amendment protections. Any such imbalance necessarily must result in the chilling of speech. *See Volokh & McDonnell* at 2437. That is particularly true for the copyright law, which imposes strict liability for subconscious copying, provides for huge damage awards against creators,[9] and where proof of copying can be established indirectly and by inference.

2. The Ninth Circuit Also Implemented And Imposed A New Standard For Protectibility Inconsistent With This Court's Ruling in Feist.

In *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 349, 359 (1991), this Court approved "thin" or "limited" copyright protection for compilations and arrangements. This is not such a case because it is not (as Respondent posits) the typical case that "consist[s] of selections and arrangements of unprotectible words or notes." (Resp. Brief at 12.) Rather, it was undisputed here only that the "combination" was of unprotectible ideas and musical devices (*see* Petition at 11 n.6). There was no claim that the "arrangement" was similar. No previous case ever had held the use of such disparate, literary devices — whether in music or other expression — to be copyright protectible.[10] The Ninth Circuit opinion not only distorts *Feist*, but once again upsets the First Amendment balance mandated by this Court:

> We note that Federal District Courts have rejected First Amendment challenges to the federal copyright law on the ground that "no restraint (has been) placed on the use of an idea or concept."

---

9. Although Respondent's Brief notes that the largest award below was against Petitioner Sony Music Entertainment Inc., creators frequently may be asked to satisfy those awards. *See* RIAA Amicus Brief at 2 n.4.

10. Also contrary to Respondent's position, the issue of substantial similarity of expression is a mixed question of law and fact. *See* Discussion, RIAA Amicus Brief at 15-17.

Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 577 n.13 (1977). Contrary to Respondent's position (Resp. Brief at 12), ideas simply are not protected, even if used in combination.[11] This is crucial because "[t]he First Amendment protections [are] already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, ..." *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 560 (1985); *see also New York Times Co. v. U.S.*, 403 U.S. 713, 726 (1971) (Brennan, J, concurring) (Copyright laws do not restrict free speech because copyright protects only expression, not ideas.) *See generally* M.B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?* 17 UCLA L. Rev. 1180 (1970). In permitting protection for "ideas," the Ninth Circuit's opinion conflicts both with *Feist* and other First Amendment/copyright decisions of this Court.

3. The Inverse Ratio Rule Presents An Issue Of Significant Importance And Was Determinative In This Case.

Contrary to Respondent's position, the Inverse Ratio Rule was of key importance to the Ninth Circuit's decision. The very first sentence of its discussion of substantial similarity invoked the Rule. 212 F.3d at 485. The Ninth Circuit's improvident and unreasoned application of the Rule as a "one way street" has never before been decided. The Rule itself is controversial (*see* Petition at 12 n.7) and has not been examined by this Court. Since (as Respondent acknowledges) copying is proven by access and substantial similarity, the relation between the two and the quantum of proof necessary for each, are implicated in a wide variety of copyright cases. *See* II P. Goldsten, Copyright § 7.2.1 at 7:7 (2nd ed. 2000) (referring to "reciprocal relationship between

11. Although this is an issue that is important to all copyright media, it is particularly important in the creation of music because "most popular music is simple by nature." (Resp. Brief at 13 n.10.)

proof of access and similarity . . ."); *see generally* 4 M. & D. Nimmer *On Copyright* § 13.01[B] at 13-11 to 13-13 (2000) (copying ordinarily established indirectly by proof of access and substantial similarity).

The Ninth Circuit reiterated that the evidence of access was "weak." 212 F.3d at 484 ("Despite the weakness of the Isley Brothers' theory of reasonable access . . ."); at 486 ("Although this may be a weak case of access . . ."); and *id.* ("In this case, there was a weak showing of access"). Given that fact, its refusal to apply the Inverse Ratio Rule evenly and reciprocally clearly was outcome-determinative; otherwise there would not have been any reason to discuss the Rule. What the Ninth Circuit did, in this issue of first impression but of broad importance, was to permit greater evidence of substantial similarity to replace at least some otherwise necessary evidence of access (thereby giving added weight to the copyright side of the free speech balance), but not to permit reciprocal application, i.e., to require greater similarity where evidence of access was "weak." *See* Discussion, RIAA Amicus Brief at 18-19. The Ninth Circuit's opinion skews the balance by prohibiting speech (as copyright protected) while limiting First Amendment protections. Contrary to Respondent's position (Resp. Brief at 15) Petitioners do not seek a new standard. By use of the Inverse Ratio Rule in the first place, courts already have imposed a sliding scale standard. Petitioners only asked that the standard be applied equally and reciprocally, as the First Amendment requires.

CONCLUSION

Respondent ignores that the issues presented involve serious First Amendment implications and the gatekeeping function of the courts required to balance those concerns with copyright protection. The Ninth Circuit's return to a rule of complete "judicial deference" splits that Court from other Circuits and is contrary to the decisions of this Court. For all of the reasons presented in the Petition and here, Petitioners respectfully submit that the Petition should be granted.

Respectfully submitted,

ROBERT G. SUGARMAN
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
(212) 310-8184

ALAN M. DERSHOWITZ
Counsel of Record
1525 Massachusetts Avenue
Cambridge, MA 02138
(617) 495-4617

RUSSELL J. FRACKMAN
MITCHELL SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064
(310) 312-2000

Attorneys for Petitioners